

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Kevin J. Zilka et al.

Application No.: 10/661,878

Group No.: 3629

Filed: September 11, 2003

Examiner: Mooneyham, Janice A.

For: SYSTEM, METHOD AND COMPUTER PROGRAM PRODUCT FOR COLLECTING
STRATEGIC PATENT DATA ASSOCIATED WITH AN IDENTIFIER

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P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF
(PATENT APPLICATION--37 C.F.R. § 41.37)

1. This brief is in furtherance of the Notice of Appeal, filed in this case on 03/25/2008.

2. STATUS OF APPLICANT

This application is on behalf of a small entity. A statement was already filed on September 11, 2003.

3. FEE FOR FILING APPEAL BRIEF

Pursuant to 37 C.F.R. § 41.20(b)(2), the fee for filing the Appeal Brief is:

small entity	\$255.00
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Appeal Brief fee due	\$255.00
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4. EXTENSION OF TERM

The proceedings herein are for a patent application and the provisions of 37 C.F.R. § 1.136 apply.

Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

5. TOTAL FEE DUE

The total fee due is:

Appeal brief fee	\$0.00 (previously paid on 11/22/2005)
Extension fee (if any)	\$0.00

TOTAL FEE DUE	\$0.00
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6. FEE PAYMENT

Applicant believes that no fees are due in connection with the filing of this paper because the Appeal Brief fee was paid with a previous submission. However, the Commissioner is authorized to charge any additional fees that may be due (e.g. for any reason including, but not limited to, fee changes, etc.) to Deposit Account No. 50-1351 (Order No.SVIPGP002B).

7. FEE DEFICIENCY

If any additional extension and/or fee is required, and if any additional fee for claims is required, charge Deposit Account No. 50-1351 (Order No.SVIPGP002B).

Date: May 27, 2008

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:)	
)	
Kevin J. Zilka et al.)	Group Art Unit: 3629
)	
Application No. 10/661,878)	Examiner: Mooneyham, Janice A.
)	
Filed: 09/11/2003)	Atty. Docket No.:
)	SVIPGP002B
)	
For: SYSTEM, METHOD AND COMPUTER)	
PROGRAM PRODUCT FOR)	Date: 05/27/2008
COLLECTING STRATEGIC PATENT)	
DATA ASSOCIATED WITH AN)	
IDENTIFIER)	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

ATTENTION: Board of Patent Appeals and Interferences

APPEAL BRIEF (37 C.F.R. § 41.37)

This brief is in furtherance of the Notice of Appeal, filed in this case on 03/25/2008.

The fees required under § 1.17, and any required petition for extension of time for filing this brief and fees therefor, are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief contains these items under the following headings, and in the order set forth below (37 C.F.R. § 41.37(c)(i)):

- I REAL PARTY IN INTEREST
- II RELATED APPEALS AND INTERFERENCES
- III STATUS OF CLAIMS
- IV STATUS OF AMENDMENTS
- V SUMMARY OF CLAIMED SUBJECT MATTER

- VI GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL
- VII ARGUMENT
- VIII CLAIMS APPENDIX
- IX EVIDENCE APPENDIX
- X RELATED PROCEEDING APPENDIX

The final page of this brief bears the practitioner's signature.

I REAL PARTY IN INTEREST (37 C.F.R. § 41.37(c)(1)(i))

The real parties in interest in this appeal are Aloft Media, LLC.

II RELATED APPEALS AND INTERFERENCES (37 C.F.R. § 41.37(c) (1)(ii))

With respect to other prior or pending appeals, interferences, or related judicial proceedings that will directly affect, or be directly affected by, or have a bearing on the Board's decision in the pending appeal, an appeal noted on 05/01/2006 in application serial number 10/691,090 (pending), an appeal noted on 05/21/07 in application serial number 10/324,887 (pending), an appeal noted on 11/21/2005 in application serial number 10/661,938 (pending), an appeal noted on 07/07/2006 in application serial number 10/661,855 (pending), an appeal noted on 07/21/2005 in application serial number 10/660,830 (see attached decision), and an appeal noted on 04/07/2005 in application serial number 10/691,060 (see attached decision) may be, but are not necessarily, related.

Any relevant decision(s) that have been rendered in such proceeding(s) are attached in the Related Proceedings Appendix appended hereto.

III STATUS OF CLAIMS (37 C.F.R. § 41.37(c) (1)(iii))

A. TOTAL NUMBER OF CLAIMS IN APPLICATION

Claims in the application are: 1, 2, 4-13, 18-20, 44, and 45

B. STATUS OF ALL THE CLAIMS IN APPLICATION

1. Claims withdrawn from consideration: None
2. Claims pending: 1, 2, 4-13, 18-20, 44, and 45
3. Claims allowed: None
4. Claims rejected: 1, 2, 4-13, 18-20, 44, and 45
5. Claims cancelled: 3, 14-17, and 21-43

C. CLAIMS ON APPEAL

The claims on appeal are: 1, 2, 4-13, 18-20, 44, and 45

See additional status information in the Appendix of Claims.

IV STATUS OF AMENDMENTS (37 C.F.R. § 41.37(c)(1)(iv))

As to the status of any amendment filed subsequent to final rejection, the amendments submitted on 07/21/2005 and 02/16/2007 were entered by the Examiner.

V SUMMARY OF CLAIMED SUBJECT MATTER (37 C.F.R. § 41.37(c)(1)(v))

With respect to a summary of Claim 1, as shown in Figures 8, 13, 13A, 13B, and 14-18 et al.; a computer program product embodied on a computer readable medium for organizing patents utilizing a computer-implemented system is provided. The computer program product comprises computer code for displaying a notes field (e.g. see item 808 of Figure 8, etc.) for receiving manually entered notes including text. Additionally, the computer program product comprises computer code for receiving the manually entered notes, utilizing the notes field. Further, the computer program product comprises computer code for storing the manually entered notes in association with at least one identifier, thus associating the manually entered notes with the at least one identifier. Further still, the computer program product comprises computer code for receiving the manual selection of a file. Also, the computer program product comprises computer code for storing the manually selected file in association with the at least one identifier by providing a correspondence between the file and the at least one identifier, thus associating the manually selected file with the at least one identifier. In addition, a manually selected first file is associated with a first identifier corresponding to a single patent, and a manually selected second file is associated with a second identifier corresponding to a group involving a plurality of patents.

Furthermore, the computer program product comprises computer code for associating a plurality of patents with the at least one identifier. Further still, the manually entered notes, at least one of the manually selected files, and the patents are accessible by subsequent selection of the at least one identifier. Also, a set of the patents is reported using computer code for displaying a technology mapping depicting a plurality of categories of technology utilizing a graphical user interface (e.g. see item 1300 of Figure 13, item 1350 of Figure 13A, item 1380 of Figure 13B, operation 1402 of Figure 14, etc.). Additionally, the set of the patents is reported using computer code for displaying statistics regarding a number of the patents of the set in each of the categories of technology in a first interface (e.g. see operation 1404 of Figure 14, etc.). Further, the set of the patents is reported using computer code for displaying first additional information associated with at least a portion of the patents of the set in a second interface (e.g. see item 1500 of Figure 15, etc.) separate from the first interface upon the selection of an icon (e.g. see operation 1406 of Figure 14, etc.) positioned in the first interface and associated with one of the

statistics, for drilling down from the first interface to the second interface. Further still, the first additional information includes a list (e.g. see item 1502 of Figure 15, etc.) of the patents of the set associated with one of the categories of technology. Also, the set of the patents is reported using computer code for displaying second additional information associated with at least one of the patents of the list in a third interface (e.g. see item 1600 of Figure 16, item 1700 of Figure 17, item 1800 of Figure 18, etc.) separate from the first interface and the second interface upon the selection of an additional icon positioned in the second interface and associated with one of the patents (e.g. see operation 1408 of Figure 14, etc.), for drilling down from the second interface to the third interface. In addition, the second additional information includes at least one of a patent number, a status, an exemplary claim, and an exemplary figure. Furthermore, the notes and at least one of the files are made accessible to other parties utilizing e-mail. See, for example, page 2, lines 6-11; page 31, lines 20-22 and 25-26; page 32, lines 4-6; and page 33, lines 17-18 et al.

With respect to a summary of Claim 18, as shown in Figures 13, 13A, 13B, and 14-18 et al., a computer readable medium encoded with an intellectual property data structure for realizing the function of organizing and reporting information associated with an identifier is provided. The computer readable medium comprises an identifier object. Additionally, the computer readable medium comprises a notes object correlated with the identifier object for tracking manually entered notes including text associated with the identifier object. Further, the computer readable medium comprises at least one file object correlated with the identifier object by providing a correspondence between the file object and the identifier object, for tracking manually selected files associated with the identifier object. Further still, a manually selected first file is associated with a first identifier corresponding to a single patent, and a manually selected second file is associated with a second identifier corresponding to a group involving a plurality of patents.

Also, the computer readable medium comprises at least one patent object correlated with the identifier object for tracking a plurality of related patent identifiers associated with the identifier object. In addition, a set of the patents is reported utilizing the computer readable medium with computer code for displaying a technology mapping depicting a plurality of categories of technology utilizing a graphical user interface (e.g. see item 1300 of Figure 13, item 1350 of Figure 13A, item 1380 of Figure 13B, operation 1402 of Figure 14, etc.). Further, the set of the patents is reported utilizing the computer readable medium with computer code for displaying

statistics regarding a number of the patents of the set in each of the categories of technology in a first interface (e.g. see operation 1404 of Figure 14, etc.). Further still, the set of the patents is reported utilizing the computer readable medium with computer code for displaying first additional information associated with at least a portion of the patents of the set in a second interface (e.g. see item 1500 of Figure 15, etc.) separate from the first interface upon the selection of an icon (e.g. see operation 1406 of Figure 14, etc.) positioned in the first interface and associated with one of the statistics, for drilling down from the first interface to the second interface. Also, the first additional information includes a list (e.g. see item 1502 of Figure 15, etc.) of the patents of the set associated with one of the categories of technology. Additionally, the set of the patents is reported utilizing the computer readable medium with computer code for displaying second additional information associated with at least one of the patents of the list in a third interface (e.g. see item 1600 of Figure 16, item 1700 of Figure 17, item 1800 of Figure 18, etc.) separate from the first interface and the second interface upon the selection of an additional icon positioned in the second interface and associated with one of the patents (e.g. see operation 1408 of Figure 14, etc.), for drilling down from the second interface to the third interface. Further, the second additional information includes a patent number, a status, an exemplary claim, and an exemplary figure. Further still, the notes and at least one of the files are made accessible to other parties utilizing e-mail. See, for example, page 2, lines 6 and 8-10; page 31, lines 20-22 and 25-26; page 32, lines 4-6; and page 33, lines 17-18 et al.

With respect to a summary of Claim 19, as shown in Figures 1, 8, 13, 13A, 13B, and 14-18 et al., a method for organizing patents utilizing a computer-implemented system is provided. In use, a notes field (e.g. see item 808 of Figure 8, etc.) is displayed for receiving manually entered notes including text. Additionally, the manually entered notes are received, utilizing the notes field. Further, the manually entered notes are stored in association with at least one identifier, thus associating the manually entered notes with the at least one identifier. Further still, the manual selection of a file is received. Also, the manually selected file is stored in association with the at least one identifier by providing a correspondence between the file and the at least one identifier, thus associating the manually selected file with the at least one identifier. In addition, a manually selected first file is associated with a first identifier corresponding to a single patent, and a manually selected second file is associated with a second identifier corresponding to a group involving a plurality of patents. Furthermore, a plurality of patents is associated with the

at least one identifier. Further still, the manually entered notes, at least one of the manually selected files, and the patents are accessible by subsequent selection of the at least one identifier. Also, the notes field allows a user to cut and paste notes.

Additionally, the file is selected utilizing a file structure field including a file tree-structure that allows a user to browse various folders where files have been previously stored, where the file structure is displayed simultaneously with the notes field on the same interface, the file selected utilizing the file tree-structure including information from a source separate from the patents. Further, the patents associated with the at least one identifier are identified by searching a database (e.g. see item 120 of Figure 1, etc.) including a comprehensive database of all patents issued by at least one government agency. Further still, a set of the patents is reported by displaying a technology mapping depicting a plurality of categories of technology utilizing a graphical user interface (e.g. see item 1300 of Figure 13, item 1350 of Figure 13A, item 1380 of Figure 13B, operation 1402 of Figure 14, etc.). Also, the set of the patents is reported by displaying statistics regarding a number of the patents of the set in each of the categories of technology in a first interface (e.g. see operation 1404 of Figure 14, etc.). In addition, the set of the patents is reported by displaying first additional information associated with at least a portion of the patents of the set in a second interface (e.g. see item 1500 of Figure 15, etc.) separate from the first interface upon the selection of an icon (e.g. see operation 1406 of Figure 14, etc.) positioned in the first interface and associated with one of the statistics, for drilling down from the first interface to the second interface. Furthermore, the first additional information includes a list (e.g. see item 1502 of Figure 15, etc.) of the patents of the set associated with one of the categories of technology. Further still, the set of the patents is reported by displaying second additional information associated with at least one of the patents of the list in a third interface (e.g. see item 1600 of Figure 16, item 1700 of Figure 17, item 1800 of Figure 18, etc.) separate from the first interface and the second interface upon the selection of an additional icon positioned in the second interface and associated with one of the patents (e.g. see operation 1408 of Figure 14, etc.), for drilling down from the second interface to the third interface. Also, the second additional information includes at least one of a patent number, a status, an exemplary claim, and an exemplary figure. Additionally, the notes and at least one of the files are made accessible to other parties utilizing e-mail. Further, said method is carried out utilizing the computer-implemented system including computer code embodied on a computer readable

medium. See, for example, page 2, lines 6-11; page 9, lines 3-5; page 21, lines 12-13; page 31, lines 20-22 and 25-26; page 32, lines 4-6; and page 33, lines 17-18 et al.

With respect to a summary of Claim 20, as shown in Figures 8, 13, 13A, 13B, and 14-18 et al., a system for organizing patents is provided. The system comprises a computer readable medium. Additionally, the system comprises computer code for displaying a notes field (e.g. see item 808 of Figure 8, etc.) for receiving manually entered notes including text. Further, the system comprises computer code for receiving the manually entered notes, utilizing the notes field. Further still, the system comprises computer code for storing the manually entered notes in association with at least one identifier, thus associating the manually entered notes with the at least one identifier. Also, the system comprises computer code for receiving the manual selection of a file, wherein the file is selected utilizing a file structure field including a file tree-structure that allows a user to browse various folders where files have been previously stored. In addition, the file structure is displayed simultaneously with the notes field on the same interface, the file including information from a source separate from the patents. Furthermore, the system comprises computer code for storing the manually selected file in association with the at least one identifier by providing a correspondence between the file and the at least one identifier, thus associating the manually selected file with the at least one identifier. Further still, a manually selected first file is associated with a first identifier corresponding to a single patent, and a manually selected second file is associated with a second identifier corresponding to a group involving a plurality of patents.

Also, the system comprises computer code for associating a plurality of patents with the at least one identifier. Additionally, the manually entered notes, at least one of the manually selected files, and the patents are accessible by subsequent selection of the at least one identifier. Further, a set of the patents is reported with computer code for displaying a technology mapping depicting a plurality of categories of technology utilizing a graphical user interface (e.g. see item 1300 of Figure 13, item 1350 of Figure 13A, item 1380 of Figure 13B, operation 1402 of Figure 14, etc.). Further still, the set of the patents is reported with computer code for displaying statistics regarding a number of the patents of the set in each of the categories of technology in a first interface (e.g. see operation 1404 of Figure 14, etc.). Also, the set of the patents is reported with computer code for displaying first additional information associated with at least a portion

of the patents of the set in a second interface (e.g. see item 1500 of Figure 15, etc.) separate from the first interface upon the selection of an icon (e.g. see operation 1406 of Figure 14, etc.) positioned in the first interface and associated with one of the statistics, for drilling down from the first interface to the second interface. In addition, the first additional information includes a list (e.g. see item 1502 of Figure 15, etc.) of the patents of the set associated with one of the categories of technology. Furthermore, the set of the patents is reported with computer code for displaying second additional information associated with at least one of the patents of the list in a third interface (e.g. see item 1600 of Figure 16, item 1700 of Figure 17, item 1800 of Figure 18, etc.) separate from the first interface and the second interface upon the selection of an additional icon positioned in the second interface and associated with one of the patents (e.g. see operation 1408 of Figure 14, etc.), for drilling down from the second interface to the third interface. Further still, the second additional information includes a patent number, a status, an exemplary claim, and an exemplary figure. Also, the notes and at least one of the files are made accessible to other parties utilizing e-mail. See, for example, page 2, lines 6-11; page 31, lines 20-22 and 25-26; page 32, lines 4-6; and page 33, lines 17-18 et al.

With respect to a summary of Claim 44, as shown in Figures 13, 13A, 13B, and 14-18 et al., a computer readable medium encoded with an intellectual property data structure for realizing the function of organizing and reporting information associated with an identifier is provided. The computer readable medium comprises an identifier object. Additionally, the computer readable medium comprises a notes object correlated with the identifier object for tracking manually entered notes including text associated with the identifier object. Further, the computer readable medium comprises at least one patent object correlated with the identifier object for tracking a plurality of related patent identifiers associated with the identifier object. Further still, a set of the patents is reported utilizing the computer readable medium with computer code embodied on the computer readable medium for displaying a technology mapping depicting a plurality of categories of technology utilizing a graphical user interface (e.g. see item 1300 of Figure 13, item 1350 of Figure 13A, item 1380 of Figure 13B, operation 1402 of Figure 14, etc.). Also, the set of the patents is reported utilizing the computer readable medium with computer code embodied on the computer readable medium for displaying statistics regarding a number of the patents of the set in each of the categories of technology in a first interface (e.g. see operation 1404 of Figure 14, etc.). In addition, the set of the patents is reported utilizing the computer

readable medium with computer code embodied on the computer readable medium for displaying first additional information associated with at least a portion of the patents of the set in a second interface (e.g. see item 1500 of Figure 15, etc.) separate from the first interface upon the selection of an icon (e.g. see operation 1406 of Figure 14, etc.) positioned in the first interface and associated with one of the statistics, for drilling down from the first interface to the second interface. Furthermore, the first additional information includes a list (e.g. see item 1502 of Figure 15, etc.) of the patents of the set associated with one of the categories of technology. Further still, the set of the patents is reported utilizing the computer readable medium with computer code embodied on the computer readable medium for displaying second additional information associated with at least one of the patents of the list in a third interface (e.g. see item 1600 of Figure 16, item 1700 of Figure 17, item 1800 of Figure 18, etc.) separate from the first interface and the second interface upon the selection of an additional icon positioned in the second interface and associated with one of the patents (e.g. see operation 1408 of Figure 14, etc.), for drilling down from the second interface to the third interface. Also, the second additional information includes a patent number, a status, an exemplary claim, and an exemplary figure. Additionally, the notes are made accessible to other parties. See, for example, page 2, lines 6 and 9-10; page 31, lines 20-22 and 25-26; page 32, lines 4-6; and page 33, lines 17-18 et al.

With respect to a summary of Claim 45, as shown in Figures 13, 13A, 13B, and 14-18 et al., a computer readable medium encoded with an intellectual property data structure for realizing the function of organizing and reporting information associated with an identifier is provided. The computer readable medium comprises an identifier object. Additionally, the computer readable medium comprises a notes object correlated with the identifier object for tracking manually entered notes including text associated with the identifier object. Further, the computer readable medium comprises at least one file object correlated with the identifier object by providing a correspondence between the file object and the identifier object, for tracking manually selected files associated with the identifier object. Further still, the computer readable medium comprises at least one patent object correlated with the identifier object for tracking a plurality of related patent identifiers associated with the identifier object. Also, a set of the patents is reported utilizing the computer readable medium with computer code embodied on the computer readable medium for displaying a technology mapping depicting a plurality of categories of technology

utilizing a graphical user interface (e.g. see item 1300 of Figure 13, item 1350 of Figure 13A, item 1380 of Figure 13B, operation 1402 of Figure 14, etc.). In addition, the set of the patents is reported utilizing the computer readable medium with computer code embodied on the computer readable medium for displaying statistics regarding a number of the patents of the set in each of the categories of technology in a first interface (e.g. see operation 1404 of Figure 14, etc.). Furthermore, the set of the patents is reported utilizing the computer readable medium with computer code embodied on the computer readable medium for displaying first additional information associated with at least a portion of the patents of the set in a second interface (e.g. see item 1500 of Figure 15, etc.) separate from the first interface upon the selection of an icon (e.g. see operation 1406 of Figure 14, etc.) positioned in the first interface and associated with one of the statistics, for drilling down from the first interface to the second interface. Further still, the first additional information includes a list (e.g. see item 1502 of Figure 15, etc.) of the patents of the set associated with one of the categories of technology. Also, the set of the patents is reported utilizing the computer readable medium with computer code embodied on the computer readable medium for displaying second additional information associated with at least one of the patents of the list in a third interface (e.g. see item 1600 of Figure 16, item 1700 of Figure 17, item 1800 of Figure 18, etc.) separate from the first interface and the second interface upon the selection of an additional icon positioned in the second interface and associated with one of the patents (e.g. see operation 1408 of Figure 14, etc.), for drilling down from the second interface to the third interface. Additionally, the second additional information includes a patent number, a status, an exemplary claim, and an exemplary figure. See, for example, page 2, lines 6 and 8-10; page 31, lines 20-22 and 25-26; page 32, lines 4-6; and page 33, lines 17-18 et al.

Of course, the above citations are merely examples of the above claim language and should not be construed as limiting in any manner.

VI GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL (37 C.F.R. § 41.37(c)(1)(vi))

Following, under each issue listed, is a concise statement setting forth the corresponding ground of rejection.

Issue # 1: The Examiner has rejected Claim 1-2, 4-13, 18-20, and 44-45 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

Issue # 2: The Examiner has rejected Claims 1-2, 4-13, 18-20, and 44-45 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention.

Issue # 3: The Examiner has rejected Claim 20 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention.

Issue # 4: The Examiner has rejected Claims 1-2, 4-13, 18-20, and 44-45 under 35 U.S.C. 103(a) as being unpatentable over Rivette et al. (U.S. Patent No. 2003/0046307) in view of Barnett et al. (U.S. Patent No. 2002/0082778).

VII ARGUMENT (37 C.F.R. § 41.37(c)(1)(vii))

The claims of the groups noted below do not stand or fall together. In the present section, appellant explains why the claims of each group are believed to be separately patentable.

Issue # 1:

The Examiner has rejected Claim 1-2, 4-13, 18-20, and 44-45 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

Group #1: Claims 1-2, 4-13, 18-20 and 44-45

It should be strongly noted that the excerpts cited below are set forth for illustrative purposes for purpose of providing at least one exemplary embodiment of the cited claim language. The claim language should not be construed as being limited to such exemplary excerpts in any manner whatsoever.

Specifically, the Examiner has argued the following:

Applicant has amended the independent claims to include the limitation of displaying statistics regarding a number of the patents of the set in each category of technology *in a first interface*, displaying first additional information associated with at least a portion of the patents of the set *in a second interface separate from the first interface* upon the selection of an icon *positioned in the first interface and associated with one of the statistics, for drilling down from the first interface to the second*,

displaying second additional information associated with at least one of the patents of the list *in a third interface separate from the first interface and the second interface* upon the selection of an additional icon *positioned in the second interface and associated with one of the patents for drilling down from the second interface to the third interface*

The Examiner request that the applicant direct the Examiner to where there is support for the newly added limitations.

In response, appellant draws the Examiner's attention to Figures 13, 15-16 and the quoted excerpt from page 29, lines 22-24; page 32, lines 8-25; and page 33, lines 6-14.

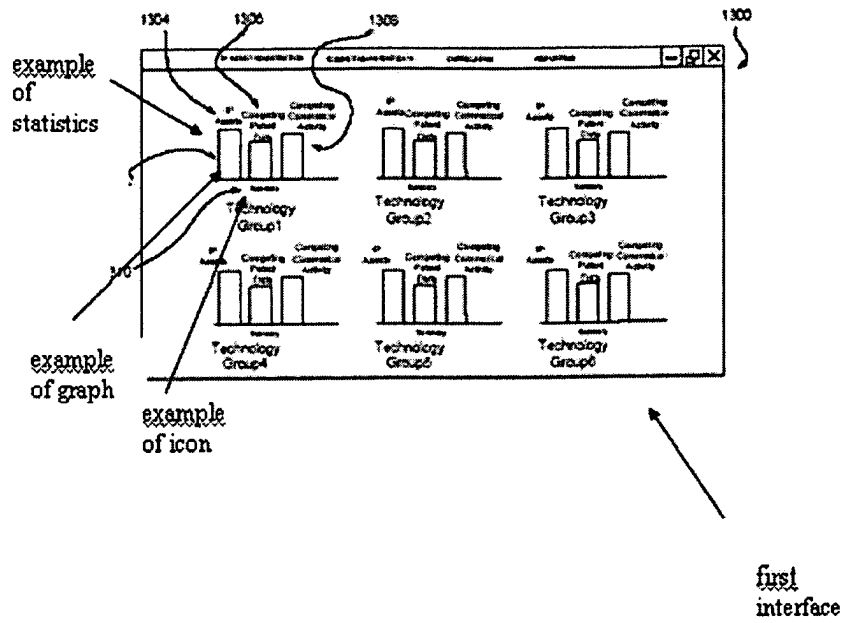


Figure 13

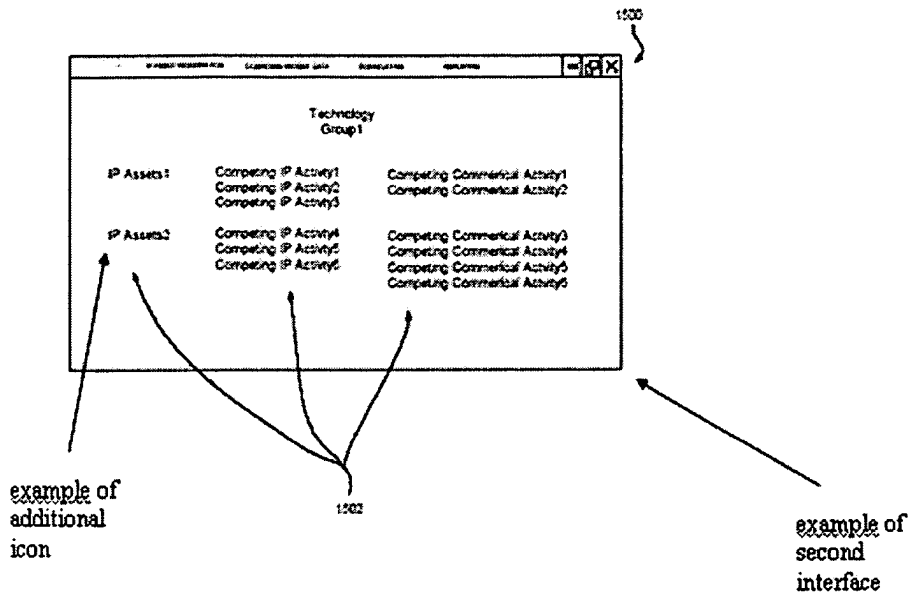


Figure 15

“Figure 15 illustrates an exemplary summary report 1500, in accordance with one embodiment. Such report 1500 may be displayed in response to the selection of the summary icon 1310 of one of the technology categories shown in the interface 1300 of Figure 13. In the alternative, such page may be generated in utilizing the report definition interface 1200 by selecting a particular technology category via pull-down window 1204, selecting all of the intellectual property identifiers via pull-down window 1202, and selecting a summary format type. Of course, the summary report 1500 may be generated in any desired manner.” (emphasis added)

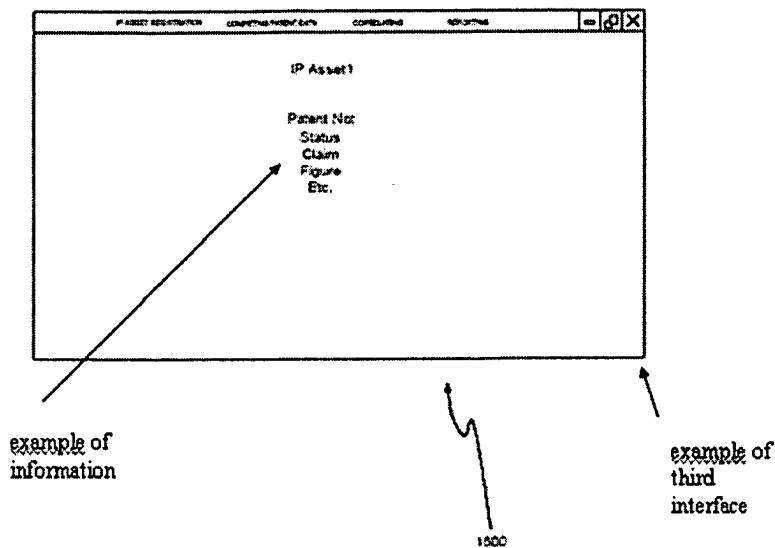


Figure 16

“In particular, upon a user selecting one of the intellectual property identifiers in the lists 1502, more information relating to such intellectual property may be presented. Figure 16 illustrates an exemplary intellectual property details report 1600, in accordance with one embodiment. As shown, a patent number, status, exemplary claim and figure, etc. may be provided in such report. It should be noted that such intellectual property details report 1600 may also be generated directly utilizing the report definition interface 1200 by selecting a particular intellectual property identifiers via pull-down window 1202, and selecting a details format type.” (emphasis added)

“As shown, the summary report 1500 lists each of the intellectual property identifiers, each competing patent, and each instance of competing activity associated with the appropriate technology category. For reasons that will soon become apparent, each item in the lists 1502 may include a link to an additional page with more information.

In an alternate embodiment, an intellectual property identifier icon, competing patent icon, or a competing activity documentation icon may be selected separately.” (emphasis added)

“It should be noted that the electronic versions of the report (those that are displayed utilizing a computer) may include interactive features to further analyze the data by **drilling down** into selected areas.” (emphasis added)

Thus, in view of the experts provided above, appellant respectfully asserts that Claims 1-2, 4-13, 18-20 and 44-45 comply with the written description requirement under 35 U.S.C. 112, first paragraph.

In the Office Action dated 12/27/2007, the Examiner has argued the following:

Thus, while applicant's disclosure discloses that selection of one of the patents may product specific information regarding such patent, that the electronic version of the report may include interactive feature, a graphical user interface (GUI) which is equipped for reporting on IP management, that the user may be allowed to select a summary icon on the GUI wherein such icon may act as a link to another page which sets forth additional information, that a summary report may be displayed in response to the selection of the summary icon of one of the technology categories or that the page may be generated by selecting a pull-down window, and that the summary report may be generated in any desired manner, applicant's disclosure does not disclose displaying first additional information associated with at least a portion of the patents of the set in a second interface separate from the first interface upon the selection of an icon positioned in the first interface and associated with one of the statistics, for drilling down from the first interface to the second, displaying second additional information

associated with at least one of the patents of the list in a third interface separate from the first interface and second interface upon the selection of an additional icon positioned in the second interface and associated with one of the patents for drilling down from the second interface to the third interface. At most applicant discloses that applicant may be allowed to select a summary icon on the GUI, such icon may act as a link to another page which sets forth additional information and that the summary report lists each of the intellectual property identifiers, each competing patent, etc. and that each item in the lists may include links to an additional page. Applicant also discloses that upon a user selecting one of the intellectual property identifiers, more information relating to the property may be presented. At most, an additional page or information is presented. However, there is no disclosure that the page is separate for the first of second information. Moreover, a page is not another interface or GUI.

Appellant respectfully disagrees and again notes that the above excerpts clearly disclose that the “report 1500 may be displayed in response to the selection of the summary icon 1310 of one of the technology categories shown in the interface 1300 of Figure 13” (emphasis added), and that “upon a user selecting one of the intellectual property identifiers in the lists 1502, more information relating to such intellectual property may be presented” where “Figure 16 illustrates an exemplary intellectual property details report 1600, in accordance with one embodiment” (emphasis added). Appellant further notes that the interface 1300, the report 1500, and the intellectual property details report 1600 are all distinctly shown in Figures 13, 15, and 16, respectively.

Additionally, appellant again notes that the above excerpts further teach that “in an alternate embodiment, an intellectual property identifier icon, competing patent icon, or a competing activity documentation icon may be selected separately” (emphasis added), and that “the

electronic versions of the report (those that are displayed utilizing a computer) may include interactive features to further analyze the data by **drilling down into selected areas**” (emphasis added).

Further, appellant disagrees with the Examiner’s assertion that “a page is not another interface or GUI.” For example, appellant draws the Examiner’s attention to page 31, line 24, which discloses an “exemplary **graphical user interface 1300** of Figure 13” (emphasis added), and page 32, lines 17-21, which teach that “the summary report **1500** lists each of the intellectual property identifiers, each competing patent, and each instance of competing activity associated with the appropriate technology category” and that “each item in the lists **1502** may **include a link to an additional page** with more information” (emphasis added). Appellant again notes that the interface 1300, the report 1500, and the intellectual property details report 1600 are all distinctly shown in Figures 13, 15, and 16, respectively.

Thus, in view of the experts provided above, appellant respectfully asserts that Claims 1-2, 4-13, 18-20 and 44-45 comply with the written description requirement under 35 U.S.C. 112, first paragraph.

Issue # 2:

The Examiner has rejected Claims 1-2, 4-13, 18-20, and 44-45 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention.

Group #1: Claims 1-2, 4, 7, 10, 11, 13, 18-20, and 44-45

Specifically, the Examiner has argued the following:

The body of the claims have the following step:

storing the manually selected file in association with the at least one identifier by providing a *correspondence between the file and the at least one identifier, thus associating the manually selected file with the at least one identifier.*

First, it is not clear what applicant defines as a file. Second, what does the applicant mean by providing a correspondence between the file and the identifier. What is the applicant identifying as an identifier. Page 8 of the specification states that an identifier may include a patent number, patent application serial number, issue date, filing date, docket number, and/or any other information which identifies and/or is associated with intellectual property.

This same step has the following language:

storing the manually selected file in association with the at least one identifier by providing a correspondence between the file and the at least one identifier, thus *associating* the manually selected file with the at least one identifier, thus associating the manually selected file with the at least one identifier, *wherein a manually selected first file is associated with a first identifier corresponding to a single patent, and a manually selected second file is associated with a second identifier corresponding to a group involving a plurality of patents*

What does the applicant mean by associating the file with the identifier?

In response, appellant relies on the plain and ordinary meaning of “file” and “identifier,” “correspondence,” “associated,” etc.

In the Office Action dated 12/27/2007, the Examiner has merely reiterated the above rejection and has failed to respond to appellant’s arguments with respect to the aforementioned claim language. Thus, withdrawal of such rejection is respectfully requested.

Further, the Examiner has argued:

The applicant has a step of storing the manually entered notes in association with at least one identifier and then a step of allowing a selection of a file. Then the applicant states that a manually selected first file is associated with a first identifier corresponding to a single patent and a manually selected second file is associated with a second identifier corresponding to a group involving a plurality of patents.

First, is the first identifier the same identifier that the notes were stored with?

Secondly, the applicant states that the notes are stored in association with at least one identifier, requiring only one identifier. If there is only one identifier, how can there be a first and second identifier. Are these in addition to the identifier stored with the notes?

Furthermore, the applicant has a step of allowing the manual selection of a file. If there is only one file, how can there be a first file and a second file?

Regarding the first inquiry, the claim language is purposefully drafted in a broad manner so not to be limited to a scenario where “the first identifier is the same identifier that the notes were stored with.” In other words, it may or may not be and to specify one way or another would be unduly limiting to the claims.

In the Office Action dated 12/27/2007, the Examiner has merely reiterated the above rejection and has failed to respond to appellant’s arguments with respect to the aforementioned claim language. Thus, withdrawal of such rejection is respectfully requested.

Regarding the second inquiry, the claims do not require “only one identifier,” but rather “at least one.”

In the Office Action dated 12/27/2007, the Examiner has argued that appellant’s above response is “non-responsive to the question” of “[i]f there is only one file, how can there be a first file and a second file?” Appellant respectfully disagrees and notes that appellant specifically claims

“receiving the manual selection of a file,” not that “there is only one file,” as asserted by the Examiner.

Also, the Examiner has argued the following:

The applicant has a step of *associating a plurality of patents with the at least one identifier*. Page 8 of the specification states that an identifier may include a patent number, patent application serial number, issue date, filing date, docket number, and/or any other information which identifies and/or is associated with intellectual property.

Thus, how can a plurality of patents be associated with one patent number?

Appellant respectfully asserts that the claims are not limited to “a plurality of patents [being] associated with one patent number,” as suggested by the Examiner.

Still yet, the Examiner has argued:

The applicant states in the preamble that the invention is a method for organizing patents. Then the applicant list the steps of displaying a notes field, storing the manually entered notes in association with an identifier, allowing the selection of a file, storing the file with the identifier and associating a plurality of patents with the identifier. The applicant then adds the language “wherein the manually entered notes, at least one of the manually selected files, and the patents are accessible by subsequent selection of the at least one identifier. What does the applicant mean by accessible? It is not clear what applicant is claiming in this step.

In response, appellant relies on the plain and ordinary meaning of “accessible.”

In the Office Action dated 12/27/2007, the Examiner has merely reiterated the above rejection and has failed to respond to appellant's arguments with respect to the aforementioned claim language. Thus, withdrawal of such rejection is respectfully requested.

Moreover, the Examiner has argued:

The applicant then has added the language that "wherein a set of patents is *reported by* – what does the applicant mean by "reported"? What set of patents are being reported?

In response, appellant relies on the plain and ordinary meaning of "reported." Further, the claims have been clarified.

In the Office Action dated 12/27/2007, the Examiner has argued that appellant's above statement "is non-responsive to the question." Appellant respectfully disagrees and again notes that appellant relies on the plain and ordinary meaning of "reported." Further, appellant respectfully notes that appellant specifically claims that "a set of the patents is reported" (emphasis added), in the context claimed by appellant.

The Examiner has additionally argued the following:

The applicant then states *displaying a technology mapping depicting one category of technology utilizing a graphical user interface and displaying statistics regarding a number of patents of the set in each category of technology.*

First, applicant only claims one category of technology in the displaying of a technology mapping. Then the applicant claims displaying statistics in each category of technology. How can one category become each category? Where does the technology mapping come from?

Regarding the present inquiry, appellant respectfully asserts that the claims were clarified in the amendment dated 09/21/2007 to avoid this issue. Specifically, appellant clearly claims “displaying a technology mapping depicting a plurality of categories of technology.”

In the Office Action dated 12/27/2007, the Examiner has admitted that “applicant has amended the claims to overcome the question of how can one category become each category,” but has again argued “where does the technology mapping come from” and has further argued that “[t]he claim language up until now relates to notes fields and identifiers.” Appellant respectfully disagrees and notes that appellant specifically claims “displaying a technology mapping depicting a plurality of categories of technology utilizing a graphical user interface” (emphasis added), in the context claimed by appellant.

The Examiner has also argued:

Applicant then claims displaying first additional information associated with at least a portion of patents of the set in a second interface separate from the first interface upon the selection an positioned in the first interface and associated with one of the statistics, for drilling down from the first interface to the second interface, the first information including a list of patents of the set associated with one category of technology, displaying a second additional wherein the second additional information is selected from the group consisting of a patent number, a status, an exemplary claim, an exemplary figure information; wherein the statistics are displayed in the first interface, the first additional information is displayed in a second interface, and the second additional information is displayed in a third interface.

It is not clear how the set of patents being displayed is connected to the identifier or the file. It is unclear to the Examiner what the applicant is claiming in the claim language. Applicant has started out with a notes field, storing the notes field with an identifier, selecting a file, storing the file, associating a plurality of patents with at least one identifier (it is not clear where the plurality of patents come from since there is no search being performed), making the notes and files and patents accessible by selection of the at least one identifier (however, where is it in the claim language that the notes, files and patents where ever correlated with one identifier). Applicant then states that a set of patents is reported (however, it is not clear what set of patents or if the set of patents relate to any of the steps above), displaying a technology mapping depicting at least one category of technology (note that the patents are not mentioned in this displaying step), displaying statistics

regarding a number of patents of the set in each category (note that now we have more than one category, wherein the step above one requires one category), displaying additional information in a second interface, wherein the first additional information includes a list of the patents of the set associated with one category of technology (note that now we are back to one category of technology and that the information includes a list of the patents of the set associated with this one category of technology, however there is no earlier correlation with the technology mapping depicting at least one category of technology and a listing of patent), displaying second information associated with at least one of the patents in the list in a third interface (however, it is unclear where this list even comes from), wherein the second information is selected from the group consisting of a patent number, a status, a claim or a figure. What does this mean? Your first information is information associated with patents and your second information is a patent number, status????).

Appellant respectfully asserts that the claims were clarified in the amendment dated 09/21/2007 to avoid this issue.

In the Office Action dated 12/27/2007, the Examiner has merely "disagree[d] with [appellant's] assertion" but has failed to specifically respond to appellant's arguments with respect to the aforementioned claim language. Thus, withdrawal of such rejection is respectfully requested.

Further still, the Examiner has argued the following:

The applicant states in the claim language "that wherein the notes and at least one of the files are made accessible to other parties utilizing e-mail". This is unclear. What does the applicant mean by "made accessible?" Are they transmitted?

Appellant respectfully relies on the plain and ordinary meaning of such terms. It appears that the Examiner has taken issue with many terms that may be found in the dictionary (and are not even technical in nature). In response, appellant again respectfully relies on the plain and ordinary meaning of such terms, as evidenced by relevant dictionary definitions, etc.

In the Office Action dated 12/27/2007, the Examiner has merely reiterated the above rejection and has failed to respond to appellant's arguments with respect to the aforementioned claim language. Thus, withdrawal of such rejection is respectfully requested.

Group #2: Claim 5 and 6

With respect to dependent claims 5 and 6, the Examiner has argued the following:

In Claims 5 and 6, it is unclear what the applicant means by the language "the at least one identifier is determined utilizing an add icon" or "a modify icon".

Appellant respectfully relies on the plain and ordinary meaning of such terms. It appears that the Examiner has taken issue with many terms that may be found in the dictionary (and are not even technical in nature). In response, appellant again respectfully relies on the plain and ordinary meaning of such terms, as evidenced by relevant dictionary definitions, etc.

In the Office Action dated 12/27/2007, the Examiner has merely reiterated the above rejection and has failed to respond to appellant's arguments with respect to the aforementioned claim language. Thus, withdrawal of such rejection is respectfully requested.

Group #3: Claim 8 and 9

With respect to dependent claims 8 and 9, the Examiner has argued the following:

In Claims 8 and 9, it is unclear what the applicant means by the file is selected utilizing a file structure field? What is a file structure field? What does the applicant mean by the file structure field includes a file tree structure?

Appellant respectfully relies on the plain and ordinary meaning of such terms. It appears that the Examiner has taken issue with many terms that may be found in the dictionary (and are not even technical in nature). In response, appellant again respectfully relies on the plain and ordinary meaning of such terms, as evidenced by relevant dictionary definitions, etc.

In the Office Action dated 12/27/2007, the Examiner has merely reiterated the above rejection and has failed to respond to appellant's arguments with respect to the aforementioned claim language. Thus, withdrawal of such rejection is respectfully requested.

Group #4: Claim 12

With respect to dependent claims 12, the Examiner has argued the following:

In Claim 12, it is unclear what the applicant means by the patents associated with the at least one identifier are identified by searching a database of already existing identifiers. This is unclear. It is not clear what the applicant is searching or what the applicant is searching for.

Appellant respectfully relies on the plain and ordinary meaning of such terms. It appears that the Examiner has taken issue with many terms that may be found in the dictionary (and are not even technical in nature). In response, appellant again respectfully relies on the plain and ordinary meaning of such terms, as evidenced by relevant dictionary definitions, etc.

In the Office Action dated 12/27/2007, the Examiner has merely reiterated the above rejection and has failed to respond to appellant's arguments with respect to the aforementioned claim language. Thus, withdrawal of such rejection is respectfully requested.

Issue # 3:

The Examiner has rejected Claim 20 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention.

Group #1: Claim 20

The Examiner has argued the following:

It is not clear what statutory class applicant is coming in for. A system can be an apparatus, whereby there would need to be some recitation of structure. Applicant identifies the invention as a system comprising a computer readable medium. However, applicant has not claimed the code as being on the medium. Thus, so far, the invention appears to be directed to a system comprising a computer readable medium. It is not clear what applicant identifies as a medium in the specification. Not all computer readable mediums are statutory, ie, signals, carrier waves. Thus, it is unclear what applicant is claiming in claim 20.

Appellant respectfully disagrees and notes that appellant specifically claims “[a] system comprising... a computer readable medium.” In addition, appellant respectfully points out, just by way of example, that Figure 2 of appellant’s specification as originally filed clearly shows various examples of tangible computer readable media.

Issue # 4:

The Examiner has rejected Claims 1-2, 4-13, 18-20, and 44-45 under 35 U.S.C. 103(a) as being unpatentable over Rivette et al. (U.S. Patent No. 2003/0046307) in view of Barnett et al. (U.S. Patent No. 2002/0082778).

Group #1: Claims 1, 8-13, 18-20, and 44-45

The Examiner has relied on the Rivette and Barnett references to make a prior art showing of appellant's following claim language:

“displaying statistics regarding a number of the patents of the set in each of the categories of technology in a first interface,

displaying first additional information associated with at least a portion of the patents of the set in a second interface separate from the first interface upon the selection of an icon positioned in the first interface and associated with one of the statistics, for drilling down from the first interface to the second interface, wherein the first additional information includes a list of the patents of the set associated with one of the categories of technology,

displaying second additional information associated with at least one of the patents of the list in a third interface separate from the first interface and the second interface upon the selection of an additional icon positioned in the second interface and associated with one of the patents, for drilling down from the second interface to the third interface, wherein the second additional information includes at least one of a patent number, a status, an exemplary claim, and an exemplary figure” (see this or similar, but not necessarily identical language in the independent claims).

First, the Examiner has argued that Figures 111-112 and 117-134 of Rivette meet appellant's claimed “displaying statistics...in a first interface, displaying first additional information in a second interface..., [and] displaying second additional information in a third interface” (see this or similar, but not necessarily identical language in the independent claims).

Appellant respectfully disagrees and asserts that the description of Figures 111-112 only states that “FIG. 111 is an example display format showing the display of patent text in a first window and notes in a second window” (see Paragraph [0101]), and that “FIG. 112 is an example display format showing the display of patent text in a first window and patent image in a second window” (see Paragraph [0102]). Additionally, Figures 117-134 only disclose “an example

console screen shot,” “screen shots for creating a new group,” “screen shots for searching through the databases,” “screen shots for displaying text and images of documents,” and a “screen shot for creating a document note” (Paragraphs [0107]-[0111]), among others.

Clearly, displaying patent text, patent notes, and a patent image, as well as displaying a console screen shot and screen shots for creating a group, searching a database, displaying text and images of documents, and creating a document note, as in Rivette, fails to teach or suggest “displaying statistics...in a first interface” (emphasis added), as appellant claims. In fact, appellant notes that simply nowhere in Figures 111-112 of Rivette is there any showing of any sort of statistics, as appellant claims. Specifically, appellant points out that appellant claims “statistics regarding a number of the patents of the set in each category of technology,” in the context claimed. Figures 111-112 of Rivette only relate to patent text, patent notes, and a patent image associated with a single patent, such that Rivette does not disclose, and would not even suggest “displaying statistics regarding a number of the patents of the set in each category of technology” (emphasis added), as claimed. Similarly, Figures 111-112 of Rivette also does not show “displaying first additional information associated with at least a portion of the patents of the set in a second interface... wherein the first additional information includes a list of the patents of the set associated with one category of technology” (emphasis added), in the context claimed.

Moreover, appellant respectfully points out that on page 12 of the Office Action, the Examiner even admits that “Rivette does not explicitly [disclose]...wherein the statistics are displayed in a first interface, the first additional information is displayed in the second interface, and the second additional information is displayed in a third interface.” Thus, the Examiner has expressly acknowledged that Rivette does not disclose appellant’s claim language argued above.

Appellant further notes, however, that the Examiner relied on Figures 21-24 of Barnett in arguing that “Barnett discloses... [that] the first additional information includes a list of patents of the set associated with one category of technology, and wherein there is second additional information selected from the group consisting of a patent number, status, exemplary claim or figure, and wherein the statistics are displayed.”

Appellant respectfully asserts that the Examiner's above cited argument fails to even address appellant's claim language admitted by the Examiner to not be met by Rivette, namely "displaying statistics...in a first interface; displaying first additional information in a second interface separate from the first interface..., [and] displaying second additional information in a third interface separate from the first interface and the second interface," as claimed. Thus, appellant respectfully asserts that the Examiner has failed to make any specific prior art showing of appellant's specific claim language.

In the Office Action dated 12/27/2007, the Examiner has merely argued that the newly relied upon Figures 117-134 teach such claim language. Appellant respectfully disagrees for at least the reasons noted above.

The Examiner has also relied on Paragraph [0270] in Rivette to meet appellant's claimed "drilling down from the first interface to the second interface..., [and] drilling down from the second interface to the third interface" (see this or similar, but not necessarily identical language in the independent claims).

Appellant respectfully asserts that such excerpt from Rivette merely discloses that "[t]he operator may be able to uncover additional useful data by viewing, analyzing, and/or processing these parent and child groups, either with or without the original group." In addition, appellant notes that Paragraph [0271] in Rivette simply mentions "data drilling." Thus, it seems the Examiner has failed to consider the full weight of appellant's claimed limitations.

In particular, as noted above, Rivette only generally teaches viewing, etc. parent and child groups with or without an original group, in addition to data drilling, which fails to specifically disclose "displaying first additional information associated with at least a portion of the patents of the set in a second interface separate from the first interface upon the selection of an icon positioned in the first interface and associated with one of the statistics, for drilling down from the first interface to the second interface, wherein the first additional information includes a list of the patents of the set associated with one of the categories of technology, [and] displaying second additional information associated with at least one of the patents of the list in a third interface separate from the first interface and the second interface upon the selection of an additional icon"

positioned in the second interface and associated with one of the patents, for drilling down from the second interface to the third interface wherein the second additional information at least one of a patent number, a status, an exemplary claim, and an exemplary figure” (emphasis added), as claimed. Only appellant claims and teaches drilling down in such a specific manner.

In the Office Action dated 12/27/2007, the Examiner has merely reiterated the above rejection and has failed to respond to appellant’s arguments with respect to the aforementioned claim language. Thus, a notice of allowance or specific prior art showing of each of the foregoing claim elements, in combination with the remaining claimed features, is respectfully requested.

Furthermore, the Examiner has argued that “Rivette displays interfaces showing different information relating to patents, wherein the interfaces have three interfaces (Figs 57, 125, 117)” to meet appellant’s claimed “displaying statistics regarding a number of the patents of the set in each of the categories of technology in a first interface, displaying first additional information associated with at least a portion of the patents of the set in a second interface separate from the first interface..., [and] displaying second additional information associated with at least one of the patents of the list in a third interface separate from the first interface and the second interface” (see this or similar, but not necessarily identical language in the independent claims-emphasis added).

Again, it seems that the Examiner has failed to consider the full weight of appellant’s claim language. Appellant respectfully asserts that simply disclosing interfaces showing different patent information, as noted by the Examiner, fails to specifically disclose “displaying statistics regarding a number of the patents of the set in each of the categories of technology in a first interface, displaying first additional information associated with at least a portion of the patents of the set in a second interface separate from the first interface..., [and] displaying second additional information associated with at least one of the patents of the list in a third interface separate from the first interface and the second interface” (emphasis added), in the context claimed by appellant. Appellant also respectfully asserts that Figures 57, 125, and 117 from Rivette, as relied on by the Examiner, also fail to disclose such specific claim language.

In the Office Action dated 12/27/2007, the Examiner has merely reiterated the above rejection and has failed to respond to appellant's arguments with respect to the aforementioned claim language. Thus, a notice of allowance or specific prior art showing of each of the foregoing claim elements, in combination with the remaining claimed features, is respectfully requested.

Still yet, the Examiner has admitted that Rivette does not explicitly disclose displaying a technology mapping, but has argued that "page 2 [0025] does not exclude technology mapping." Appellant respectfully asserts that simply because the Rivette reference does not "exclude" something, does not mean it discloses, teaches, or suggests the same.

In the Office Action dated 12/27/2007, the Examiner has merely reiterated the above rejection and has failed to respond to appellant's arguments with respect to the aforementioned claim language. Thus, a notice of allowance or specific prior art showing of each of the foregoing claim elements, in combination with the remaining claimed features, is respectfully requested.

Moreover, appellant respectfully asserts that the Examiner has failed to make a specific prior art showing of all of appellant's claim limitations. For example, the Examiner has failed to make a prior art showing of appellant's claimed "displaying first additional information associated with at least a portion of the patents of the set in a second interface separate from the first interface upon the selection of an icon positioned in the first interface and associated with one of the statistics, for drilling down from the first interface to the second interface, wherein the first additional information includes a list of the patents of the set associated with one of the categories of technology, [and] displaying second additional information associated with at least one of the patents of the list in a third interface separate from the first interface and the second interface upon the selection of an additional icon positioned in the second interface and associated with one of the patents, for drilling down from the second interface to the third interface, wherein the second additional information includes at least one of a patent number, a status, an exemplary claim, and an exemplary figure" (emphasis added), as claimed.

Appellant respectfully asserts that only appellant claims and teaches drilling down based on "selection of an icon positioned in the first interface and associated with one of the statistics,"

and drilling down based on “selection of an additional icon positioned in the second interface and associated with one of the patents,” as claimed.

Appellant again emphasizes that many benefits arise from the synergy of the technology mapping, and the remaining claimed framework. Specifically, a user is capable of associating patents with at least one identifier (with additional notes associated therewith), and also obtaining technology-related metrics regarding a set of patents, with one framework that is more effectively organized (see details of claims). Specifically, only appellant teaches and claims such a drill-down technique for accessing information relating to the patents subject to the technology mapping, which is believed to be unique, when taken in combination with the remaining claim elements.

In the Office Action dated 12/27/2007, the Examiner has failed to respond to appellant’s above arguments with respect to the aforementioned claim language. Thus, a notice of allowance or specific prior art showing of each of the foregoing claim elements, in combination with the remaining claimed features, is respectfully requested.

Additionally, with respect to appellant’s independent claims, the Examiner has argued that “these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps or structure recited,” in that the “data does not alter how the system functions or the steps are performed,” and the “displaying would be performed the same regardless of the data.” The Examiner has therefore concluded that “this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability.”

Appellant respectfully disagrees and points out the following from MPEP 2106:

“The presence of the claimed nonfunctional descriptive material is not necessarily determinative of nonstatutory subject matter. For example, a computer that recognizes a particular grouping or sequence of musical notes read from memory and thereafter causes another defined series of notes to be played, requires a functional interrelationship among that data and the computing processes performed when utilizing that data. As such, a claim to that computer is statutory subject matter because it implements a statutory process.”

Appellant respectfully emphasizes that appellant claims “displaying statistics... in a first interface” where “first additional information [is displayed]...in a second interface separate from the first interface upon the selection of an icon positioned in the first interface and associated with one of the statistics, for drilling down from the first interface to the second interface,” as claimed. Clearly, such claim language requires a functional interrelationship, in that first additional information is displayed in a second interface separate from a first interface upon the selection of an icon positioned in the first interface and associated with one of the statistics displayed in the first interface, as claimed. Further, the selection of such icon results in a drilling down from the first interface to the second interface, as claimed.

Similarly, the abovementioned claim language requires a functional relationship with respect to the third interface, in that second additional information is displayed in a third interface from the first interface and the second interface upon the selection of an additional icon positioned in the second interface and associated with one of the patents, as claimed. Also, the selection of such additional icon result in a drilling down from the second interface to the third interface, as claimed.

In the Office Action dated 12/27/2007, the Examiner has argued the following:

The statement that “wherein the manually entered notes, at least one of the manually selected files and the patents are accessible by subsequent selection of the at least one identifier” does not provide for a positive recitation of accessing the notes, files or patents, not is there a positive recitation of the at least one identifier being selected and thus this language is merely non-functional descriptive data.

Appellant respectfully disagrees and notes that appellant specifically claims a technique “wherein the manually entered notes, at least one of the manually selected files, and the patents

are accessible by subsequent selection of the at least one identifier” (emphasis added), as claimed.

Additionally, in the Office Action dated 12/27/2007, the Examiner has argued the following:

The recitation of "wherein the notes field allows a user to cut and paste notes" is only descriptive of the notes field. There is no positive recitation of the user cutting and pasting notes in the notes field.

Appellant respectfully disagrees and notes that appellant specifically claims a technique “wherein the notes field allows a user to cut and paste notes” (emphasis added), as claimed.

Further, in the Office Action dated 12/27/2007, the Examiner has argued the following:

The recitation “wherein the file is selected utilizing a file structure field including a file tree structure that allows a user to browse various folders where files have been previously stored, where the file structure is displayed simultaneously with the notes field on the same interface, the file selected utilizing the file tree-structure including information from a source separate from the patents” does not provide a positive recitation of a file being selected. The fact that the file structure field includes a file tree structure is non-functional descriptive data. The fact that the file tree structure allows a user to browse various folders is not a positive recitation of folders actually being browsed. There is no positive recitation of displaying the file structure simultaneously with the notes field. Moreover, the fact that the file tree structure includes information from a source separate from the patents is non-functional descriptive data.

Appellant respectfully disagrees and notes that appellant specifically claims a technique “wherein the file is selected” (emphasis added), and further claims that “the file structure is displayed” (emphasis added), as claimed.

Further still, in the Office Action dated 12/27/2007, the Examiner has argued the following:

As for the limitation of “wherein the patents associated with the at least one identifier are identified by searching a database including a comprehensive database of all patents issued by at least one government agency is non-functional descriptive data.

Appellant respectfully disagrees and notes that appellant specifically claims “searching a database including a comprehensive database of all patents issued by at least one government agency” (emphasis added), as claimed.

Also, in the Office Action dated 12/27/2007, the Examiner has argued the following:

As for the limitation “wherein a set of the patents is reported by:
displaying a technology mapping depicting a plurality of categories of
technology utilizing a graphical user interface,
displaying statistics regarding a number of patents of the set in each of the
categories of technology in a first interface;
displaying first additional information associated with at least a portion of
the patents of the set in a second interface separate from the first interface upon

the selection of an icon positioned in the first interface and associated with one of the statistics, for drilling down from the first interface to the second interface, wherein the additional information includes a list of patents of the set associated with the one of the categories of technology;

displaying second additional information associated with at least one of the patents of the list in a third interface separate from the first interface and second interface upon the selection of an additional icon positioned in the second interface and associated with one of the patents, for drilling down from the second interface to the third interface, wherein the second additional information includes at least one of a patent number, a status, an exemplary claim and an exemplary figure" the Examiner asserts the following:

All that the is required by the claim limitations is displaying a technology mapping depicting a plurality of categories of technology, displaying statistics regarding a number of the patents of the set in each of the categories of technology in a first interface".

Appellant respectfully disagrees and notes that appellant's claimed language is to be read as claimed, and thus clearly is not limited to "displaying a technology mapping depicting a plurality of categories of technology, displaying statistics regarding a number of the patent of the set in each of the categories of technology in a first interface," as suggested by the Examiner.

In addition, in the Office Action dated 12/27/2007, the Examiner has argued the following:

Moreover, many of the differences between the prior art and applicant's claimed invention are deemed to be non-functional descriptive data.

Appellant respectfully disagrees, and refers the Examiner to the above arguments.

The Examiner has also argued the following:

The Examiner asserts that the data identifying what is displayed in the record adds little, if anything, to the claimed acts or steps and thus do not serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data which does not explicitly alter or impact the steps is non-functional descriptive data. Except for the meaning to the human mind, the data identifying what is in the record does not functionally relate to the substrate and thus does not change the steps of the method as claimed. The subjective interpretation of the data does not patentably distinguish the claimed invention.

Appellant respectfully disagrees and notes that, as shown above, appellant's aforementioned claimed language does not constitute nonfunctional descriptive material. Appellant again emphasizes that appellant claims "displaying statistics... in a first interface" where "first additional information [is displayed]...in a second interface separate from the first interface upon the selection of an icon positioned in the first interface and associated with one of the statistics, for drilling down from the first interface to the second interface," as claimed. Clearly, such claim language requires a functional interrelationship, in that first additional information is displayed in a second interface separate from a first interface upon the selection of an icon positioned in the first interface and associated with one of the statistics displayed in the first interface, as claimed. Further, the selection of such icon results in a drilling down from the first interface to the second interface, as claimed.

Again, the abovementioned claim language requires a functional relationship with respect to the third interface, in that second additional information is displayed in a third interface from the

first interface and the second interface upon the selection of an additional icon positioned in the second interface and associated with one of the patents, as claimed. Also, the selection of such additional icon results in a drilling down from the second interface to the third interface, as claimed.

The Examiner has further argued that “it would have been obvious to a person of ordinary skill in the art at the time the invention was made to display any type on the regions of the interface because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.”

In view of the above argument made by the Examiner, it seems the Examiner has simply dismissed the appellant’s claim limitations under Official Notice. In response, appellant again points out the remarks above that clearly show the manner in which some of such claims further distinguish the Rivette and Barnett references. Appellant thus formally requests a specific showing of the subject matter in ALL of the claims in any future action. Note excerpt from MPEP below.

“If the appellant traverses such an [Official Notice] assertion the examiner should cite a reference in support of his or her position.” See MPEP 2144.03.

Furthermore, in the Office Action dated 12/27/2007, the Examiner has argued the following:

Furthermore, applicant's disclosure states that the summary report 1500 may be generated in any desired manner and the details of report 1600 may be generated in any desired manner (page 32, lines 14-15 and page 33, line 15).

Thus, at the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to display the report as Rivette and Barnett have since applicant has not disclosed that displaying the

report as applicant now claims provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art would have expected applicant's invention to perform equally well with the reports and the details of the reports being generated in any desired manner, as set forth by application.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to display the reports and the details of the reports in any desired manner since, as applicant admits above, there is no advantage, particular purpose, or solution to a problem being solved.

In view of the above argument made by the Examiner, it seems the Examiner has simply dismissed the appellant's claim limitations under Official Notice. In response, appellant respectfully disagrees and notes that the language of each of appellant's independent claims specifically discloses the way in which a set of the patents is reported, as claimed, and not that the set of patents may be reported "in any desired manner," as suggested by the Examiner. Additionally, appellant notes that appellant has not admitted that "there is no advantage, particular purpose, or solution to a problem being solved" in appellant's claimed language, as asserted by the Examiner. In fact, appellant again points out the remarks above that clearly show the manner in which some of such claims further distinguish the Rivette and Barnett references. Appellant thus formally requests a specific showing of the subject matter in ALL of the claims in any future action. See MPEP 2144.03, as cited hereinabove.

The Examiner has additionally argued that the "fact that the notes and files are made accessible to other parties utilizing e-mail is old and well known." Specifically, the Examiner has argued that "it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize e-mail as a way of communication."

Appellant respectfully disagrees and points out that appellant specifically claims a technique "wherein the notes and at least one of the files are made accessible to other parties utilizing e-

mail,” as claimed. Appellant respectfully asserts that simply alleging that e-mail is well known, as noted by the Examiner, fails to consider the full weight of appellant’s claimed limitation, namely that “the notes and at least one of the files are made accessible to other parties utilizing e-mail” (emphasis added), as claimed.

Still yet, the Examiner has argued that “because of the way [the aforementioned claim language] is worded, it could encompass a person e-mailing another person to come look at the notes and files.” Appellant disagrees and respectfully asserts that appellant’s claims that “the notes and at least one of the files are made accessible... utilizing e-mail” (emphasis added), as claimed. Clearly, making notes and at least one file accessible utilizing e-mail, as claimed, does not simply “encompass a person e-mailing another person to come look at the notes and files,” as noted by the Examiner. In particular, in the situation where a person e-mails another person to come look at the notes and files, as suggested by the Examiner, requires the person to personally make the notes and files accessible to the other person.

In the Office Action dated 12/27/2007, the Examiner has argued the following:

A “traverse” is a denial of an opposing party’s allegations of fact.¹ The Examiner respectfully submits that applicants’ arguments and comments do not appear to traverse what Examiner regards as knowledge that would have been generally available to one of ordinary skill in the art at the time the invention was made. Even if one were to interpret applicants’ arguments and comments as

constituting a traverse, applicants' arguments and comments do not appear to constitute an adequate traverse because applicant has not specifically pointed out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. 27 CFR 1.104(d)(2), MPEP 707.07(a). An adequate traverse must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying Examiner's notice of what is well known to one of ordinary skill in the art. In re Boon, 439 F.2d 724, 728, 169 USPQ 231, 234 (CCPA1971). If applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. In re Chevenard, 139 F.2d 71, 60 USPQ 239 (CCPA 1943). MPEP 2144.03 Reliance on Common Knowledge in the Art or "Well Known" Prior Art. In view of applicant's failure to adequately traverse official notice, the following are admitted prior art:

wherein notes and files are made accessible to other parties utilizing e-mail.

Appellant respectfully disagrees and again points out that simply alleging that e-mail is well known, as noted by the Examiner, fails to consider the full weight of appellant's claimed limitation, namely that "the notes and at least one of the files are made accessible to other parties utilizing e-mail" (emphasis added), as claimed.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior

art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on appellant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991).

Applicant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art excerpts, as relied upon by the Examiner, fail to teach or suggest all of the claim limitations, as noted above.

Group #2: Claim 2

With respect to Claim 2, the Examiner has relied on Figure 147 and Paragraphs [0117]-[0120] and [0133]-[0134] in Rivette to make a prior art showing of appellant's claimed technique "wherein the at least one identifier is determined by selecting an already-existing identifier."

Appellant respectfully asserts that Figure 147 in Rivette merely relates to a list of patents in a repository, which clearly does not even suggest that "the at least one identifier is determined by selecting an already-existing identifier," particularly where "manually entered notes [are associated] with the at least one identifier" and "a plurality of patents [are] associated with the at least one identifier," in the context claimed (see independent claim for context).

In addition, Paragraphs [0117]-[0120] and [0133]-[0134] in Rivette simply disclose an "example console screen shot," "an example screen shot for creating a group note," "example tools bars from the console screen display," "a stacked folder icon used to represent shared groups," and "an example console used to describe shared groups." Clearly, none of such excerpts specifically disclose the "the at least one identifier," as appellant claims, in which "manually entered notes [are associated] with the at least one identifier" and "a plurality of patents [are] associated with the at least one identifier," in the context claimed. In view of the absence of appellant's claimed "at least one identifier" in such excerpts, such excerpts simply do not more specifically disclose that "the at least one identifier is determined by selecting an already-existing identifier," as claimed.

In the Office Action dated 12/27/2007, the Examiner has merely reiterated the above rejection and has failed to respond to appellant's arguments with respect to the aforementioned claim language. Thus, a notice of allowance or specific prior art showing of each of the foregoing claim elements, in combination with the remaining claimed features, is respectfully requested.

Again, appellant respectfully asserts that at least the third element of the *prima facie* case of obviousness have not been met, since the prior art excerpts, as relied upon by the Examiner, fail to teach or suggest all of the claim limitations, as noted above.

Group #3: Claim 4

With respect to Claim 4, the Examiner has relied on Official Notice in rejecting appellant's claimed technique "wherein the at least one identifier is determined by selecting an already-existing identifier utilizing a pull-down menu." Specifically, the Examiner has argued that it is obvious because, for example, "while doing a search in East, the Examiner may use a number from a pull down menu to select a search and then store this search as a new search." In addition, the Examiner has argued that "it would have been obvious...to incorporate a pull-down menu...so as to allow for easy access to the identifiers."

Appellant respectfully disagrees and asserts that, as noted above with respect to the independent claims, Rivette fails to even suggest that "the at least one identifier is determined by selecting an already-existing identifier," in the context claimed, such that it would not have been obvious for "the at least one identifier is determined by selecting an already-existing identifier utilizing a pull-down menu," as suggested by the Examiner. In fact, appellant respectfully asserts that simply using a number from a pull down menu to select a search and then storing the search as a new search, as noted by the Examiner, does not even relate to appellant's claimed "identifier" in which "manually entered notes [are associated] with the at least one identifier" and "a plurality of patents [are] associated with the at least one identifier," in the context claimed (see independent claim for context).

Thus, it again seems that the Examiner has simply dismissed the aforementioned claim language under Official Notice. In response, appellant again points out the remarks above that clearly

show the manner in which some of such claims further distinguish Rivette. Appellant thus formally requests a specific showing of the subject matter in ALL of the claims in any future action. See MPEP 2144.03, as cited hereinabove.

In the Office Action dated 12/27/2007, the Examiner has argued the following:

**In view of applicant's failure to adequately
traverse official notice, the following are admitted prior art:**

**wherein the at least one identifier is determined by selecting an already
existing identifier utilizing a pull-down menu.**

Appellant respectfully disagrees and again notes that Rivette fails to even suggest that “the at least one identifier is determined by selecting an already-existing identifier,” in the context claimed, such that it would not have been obvious for “the at least one identifier is determined by selecting an already-existing identifier utilizing a pull-down menu,” as suggested by the Examiner. In fact, appellant respectfully asserts that simply using a number from a pull down menu to select a search and then storing the search as a new search, as noted by the Examiner, does not even relate to appellant’s claimed “identifier” in which “manually entered notes [are associated] with the at least one identifier” and “a plurality of patents [are] associated with the at least one identifier,” in the context claimed (see independent claim for context). Therefore, appellant has set forth an adequate traverse, and formally requests a specific showing of the subject matter in ALL of the claims in any future action. See MPEP 2144.03, as cited hereinabove.

Again, appellant respectfully asserts that at least the third element of the *prima facie* case of obviousness have not been met, since the prior art excerpts, as relied upon by the Examiner, fail to teach or suggest all of the claim limitations, as noted above.

Group #4: Claim 5

With respect to Claim 5, the Examiner has relied on Official Notice in rejecting appellant’s claimed techniques “wherein the at least one identifier is determined utilizing an add icon.”

Specifically, the Examiner has argued that “[i]t is old and well known to add a file and thus create a new file with a new identifier.” In addition, the Examiner has argued that “it would have been obvious...to incorporate...an add icon...so as to allow for easy access to the identifiers.”

Appellant respectfully disagrees and again asserts that, as noted above with respect to the independent claims, Rivette fails to even suggest “the at least one identifier” in the context claimed by appellant, such that it would not have been obvious to determine such identifier utilizing an add icon, in the context claimed.

Thus, it again seems that the Examiner has simply dismissed the aforementioned claim language under Official Notice. In response, appellant again points out the remarks above that clearly show the manner in which some of such claims further distinguish Rivette. Appellant thus formally requests a specific showing of the subject matter in ALL of the claims in any future action. See MPEP 2144.03, as cited hereinabove.

In the Office Action dated 12/27/2007, the Examiner has argued the following:

**In view of applicant's failure to adequately
traverse official notice, the following are admitted prior art:
wherein the at least one identifier is determined utilizing an add icon**

Appellant respectfully disagrees and again notes that Rivette fails to even suggest “the at least one identifier” in the context claimed by appellant, such that it would not have been obvious to determine such identifier utilizing an add icon, in the context claimed. Therefore, appellant has set forth an adequate traverse, and formally requests a specific showing of the subject matter in ALL of the claims in any future action. See MPEP 2144.03, as cited hereinabove.

Again, appellant respectfully asserts that at least the third element of the *prima facie* case of obviousness have not been met, since the prior art excerpts, as relied upon by the Examiner, fail to teach or suggest all of the claim limitations, as noted above.

Group #5: Claim 6

With respect to Claim 6, the Examiner has relied on Official Notice in rejecting appellant's claimed technique "wherein the at least one identifier is determined utilizing a modify icon." Specifically, the Examiner has argued that "[i]t is old and well known to...modify the name of a file thus creating a new identifier." In addition, the Examiner has argued that "it would have been obvious...to incorporate...a modify icon...so as to allow for easy access to the identifiers."

Appellant respectfully disagrees and again asserts that, as noted above with respect to the independent claims, Rivette fails to even suggest "the at least one identifier" in the context claimed by appellant, such that it would not have been obvious to determine such identifier utilizing a modify icon, in the context claimed.

Thus, it again seems that the Examiner has simply dismissed the aforementioned claim language under Official Notice. In response, appellant again points out the remarks above that clearly show the manner in which some of such claims further distinguish Rivette. Appellant thus formally requests a specific showing of the subject matter in ALL of the claims in any future action. See MPEP 2144.03, as cited hereinabove.

In the Office Action dated 12/27/2007, the Examiner has argued the following:

**In view of applicant's failure to adequately
traverse official notice, the following are admitted prior art:
wherein the at least one identifier is determined utilizing a modify icon**

Appellant respectfully disagrees and again notes that Rivette fails to even suggest "the at least one identifier" in the context claimed by appellant, such that it would not have been obvious to determine such identifier utilizing a modify icon, in the context claimed. Therefore, appellant has set forth an adequate traverse, and formally requests a specific showing of the subject matter in ALL of the claims in any future action. See MPEP 2144.03, as cited hereinabove.

Again, appellant respectfully asserts that at least the third element of the *prima facie* case of obviousness have not been met, since the prior art excerpts, as relied upon by the Examiner, fail to teach or suggest all of the claim limitations, as noted above.

Group #6: Claim 7

With respect to Claim 7, the Examiner has relied on Figure 58 and item 13706 from Figure 137 in Rivette to make a prior art showing of appellant's claimed technique "wherein the notes field allows a user to cut and paste notes."

Appellant respectfully asserts that Figure 58 from Rivette merely shows the tool bar described with respect to Figure 137. However, appellant respectfully asserts that the description of item 13706 in Figure 137, as relied on by the Examiner, only discloses that "[a]n operator presses a Delete The Selected Group Or Patent Note button 13706 in order to delete the note selected in the Notes window 11708" (see Paragraph [1173]-emphasis added). Clearly, deleting a group or patent, as in Rivette, fails to meet appellant's claimed "notes field [that] allows a user to cut and paste notes" (emphasis added), as claimed.

In the Office Action dated 12/27/2007, the Examiner has merely reiterated the above rejection and has failed to respond to appellant's arguments with respect to the aforementioned claim language. Thus, a notice of allowance or specific prior art showing of each of the foregoing claim elements, in combination with the remaining claimed features, is respectfully requested.

Again, appellant respectfully asserts that at least the third element of the *prima facie* case of obviousness have not been met, since the prior art excerpts, as relied upon by the Examiner, fail to teach or suggest all of the claim limitations, as noted above.

In view of the remarks set forth hereinabove, all of the independent claims are deemed allowable, along with any claims depending therefrom.

VIII CLAIMS APPENDIX (37 C.F.R. § 41.37(c)(1)(viii))

The text of the claims involved in the appeal (along with associated status information) is set forth below:

1. (Previously Presented) A computer program product embodied on a computer readable medium for organizing patents utilizing a computer-implemented system, comprising:

- computer code for displaying a notes field for receiving manually entered notes including text;

- computer code for receiving the manually entered notes, utilizing the notes field;

- computer code for storing the manually entered notes in association with at least one identifier, thus associating the manually entered notes with the at least one identifier;

- computer code for receiving the manual selection of a file;

- computer code for storing the manually selected file in association with the at least one identifier by providing a correspondence between the file and the at least one identifier, thus associating the manually selected file with the at least one identifier, wherein a manually selected first file is associated with a first identifier corresponding to a single patent, and a manually selected second file is associated with a second identifier corresponding to a group involving a plurality of patents; and

- computer code for associating a plurality of patents with the at least one identifier;

- wherein the manually entered notes, at least one of the manually selected files, and the patents are accessible by subsequent selection of the at least one identifier;

- wherein a set of the patents is reported using:

- computer code for displaying a technology mapping depicting a plurality of categories of technology utilizing a graphical user interface,

- computer code for displaying statistics regarding a number of the patents of the set in each of the categories of technology in a first interface,

- computer code for displaying first additional information associated with at least a portion of the patents of the set in a second interface separate from the first interface upon the selection of an icon positioned in the first interface and associated with one of the statistics, for drilling down from the first interface to the second interface, wherein the first additional

information includes a list of the patents of the set associated with one of the categories of technology,

computer code for displaying second additional information associated with at least one of the patents of the list in a third interface separate from the first interface and the second interface upon the selection of an additional icon positioned in the second interface and associated with one of the patents, for drilling down from the second interface to the third interface, wherein the second additional information includes at least one of a patent number, a status, an exemplary claim, and an exemplary figure;

wherein the notes and at least one of the files are made accessible to other parties utilizing e-mail.

2. (Previously Presented) The computer program product of claim 1, wherein the at least one identifier is determined by selecting an already-existing identifier.
3. (Cancelled)
4. (Previously Presented) The computer program product of claim 1, wherein the at least one identifier is determined by selecting an already-existing identifier utilizing a pull-down menu.
5. (Previously Presented) The computer program product of claim 1, wherein the at least one identifier is determined utilizing an add icon.
6. (Previously Presented) The computer program product of claim 1, wherein the at least one identifier is determined utilizing a modify icon.
7. (Previously Presented) The computer program product of claim 1, wherein the notes field allows a user to cut and paste notes.
8. (Previously Presented) The computer program product of claim 1, wherein the file is selected utilizing a file structure field.

9. (Previously Presented) The computer program product of claim 8, wherein the file structure field includes a file tree-structure.

10. (Previously Presented) The computer program product of claim 8, wherein the file structure field allows a user to browse various folders where files have been previously stored.

11. (Previously Presented) The computer program product of claim 8, wherein the file structure is displayed simultaneously with the notes field on the same interface.

12. (Previously Presented) The computer program product of claim 1, wherein the patents associated with the at least one identifier are identified by searching a database of already existing identifiers.

13. (Previously Presented) The computer program product of claim 12, wherein the database is a comprehensive database of all patents issued by at least one government agency.

14 – 17. (Cancelled)

18. (Previously Presented) A computer readable medium encoded with an intellectual property data structure for realizing the function of organizing and reporting information associated with an identifier, comprising:

- an identifier object;

- a notes object correlated with the identifier object for tracking manually entered notes including text associated with the identifier object;

- at least one file object correlated with the identifier object by providing a correspondence between the file object and the identifier object, for tracking manually selected files associated with the identifier object, wherein a manually selected first file is associated with a first identifier corresponding to a single patent, and a manually selected second file is associated with a second identifier corresponding to a group involving a plurality of patents; and

- at least one patent object correlated with the identifier object for tracking a plurality of related patent identifiers associated with the identifier object;

- wherein a set of the patents is reported utilizing the computer readable medium with:

computer code for displaying a technology mapping depicting a plurality of categories of technology utilizing a graphical user interface,

computer code for displaying statistics regarding a number of the patents of the set in each of the categories of technology in a first interface,

computer code for displaying first additional information associated with at least a portion of the patents of the set in a second interface separate from the first interface upon the selection of an icon positioned in the first interface and associated with one of the statistics, for drilling down from the first interface to the second interface, wherein the first additional information includes a list of the patents of the set associated with one of the categories of technology,

computer code for displaying second additional information associated with at least one of the patents of the list in a third interface separate from the first interface and the second interface upon the selection of an additional icon positioned in the second interface and associated with one of the patents, for drilling down from the second interface to the third interface, wherein the second additional information includes a patent number, a status, an exemplary claim, and an exemplary figure;

wherein the notes and at least one of the files are made accessible to other parties utilizing e-mail.

19. (Previously Presented) A method for organizing patents utilizing a computer-implemented system, comprising:

displaying a notes field for receiving manually entered notes including text;

receiving the manually entered notes, utilizing the notes field;

storing the manually entered notes in association with at least one identifier, thus associating the manually entered notes with the at least one identifier;

receiving the manual selection of a file;

storing the manually selected file in association with the at least one identifier by providing a correspondence between the file and the at least one identifier, thus associating the manually selected file with the at least one identifier, wherein a manually selected first file is associated with a first identifier corresponding to a single patent, and a manually selected second file is associated with a second identifier corresponding to a group involving a plurality of patents; and

associating a plurality of patents with the at least one identifier;

wherein the manually entered notes, at least one of the manually selected files, and the patents are accessible by subsequent selection of the at least one identifier;

wherein the notes field allows a user to cut and paste notes;

wherein the file is selected utilizing a file structure field including a file tree-structure that allows a user to browse various folders where files have been previously stored, where the file structure is displayed simultaneously with the notes field on the same interface, the file selected utilizing the file tree-structure including information from a source separate from the patents;

wherein the patents associated with the at least one identifier are identified by searching a database including a comprehensive database of all patents issued by at least one government agency;

wherein a set of the patents is reported by:

displaying a technology mapping depicting a plurality of categories of technology utilizing a graphical user interface,

displaying statistics regarding a number of the patents of the set in each of the categories of technology in a first interface,

displaying first additional information associated with at least a portion of the patents of the set in a second interface separate from the first interface upon the selection of an icon positioned in the first interface and associated with one of the statistics, for drilling down from the first interface to the second interface, wherein the first additional information includes a list of the patents of the set associated with one of the categories of technology,

displaying second additional information associated with at least one of the patents of the list in a third interface separate from the first interface and the second interface upon the selection of an additional icon positioned in the second interface and associated with one of the patents, for drilling down from the second interface to the third interface, wherein the second additional information includes at least one of a patent number, a status, an exemplary claim, and an exemplary figure;

wherein the notes and at least one of the files are made accessible to other parties utilizing e-mail;

wherein said method is carried out utilizing the computer-implemented system including computer code embodied on a computer readable medium.

20. (Previously Presented) A system for organizing patents, comprising:
- a computer readable medium;
 - computer code for displaying a notes field for receiving manually entered notes including text;
 - computer code for receiving the manually entered notes, utilizing the notes field;
 - computer code for storing the manually entered notes in association with at least one identifier, thus associating the manually entered notes with the at least one identifier;
 - computer code for receiving the manual selection of a file, wherein the file is selected utilizing a file structure field including a file tree-structure that allows a user to browse various folders where files have been previously stored, where the file structure is displayed simultaneously with the notes field on the same interface, the file including information from a source separate from the patents;
 - computer code for storing the manually selected file in association with the at least one identifier by providing a correspondence between the file and the at least one identifier, thus associating the manually selected file with the at least one identifier, wherein a manually selected first file is associated with a first identifier corresponding to a single patent, and a manually selected second file is associated with a second identifier corresponding to a group involving a plurality of patents; and
 - computer code for associating a plurality of patents with the at least one identifier;
 - wherein the manually entered notes, at least one of the manually selected files, and the patents are accessible by subsequent selection of the at least one identifier;
 - wherein a set of the patents is reported with computer code for:
 - displaying a technology mapping depicting a plurality of categories of technology utilizing a graphical user interface,
 - displaying statistics regarding a number of the patents of the set in each of the categories of technology in a first interface,
 - displaying first additional information associated with at least a portion of the patents of the set in a second interface separate from the first interface upon the selection of an icon positioned in the first interface and associated with one of the statistics, for drilling down from the first interface to the second interface, wherein the first additional information includes a list of the patents of the set associated with one of the categories of technology,

displaying second additional information associated with at least one of the patents of the list in a third interface separate from the first interface and the second interface upon the selection of an additional icon positioned in the second interface and associated with one of the patents, for drilling down from the second interface to the third interface, wherein the second additional information includes a patent number, a status, an exemplary claim, and an exemplary figure;

wherein the notes and at least one of the files are made accessible to other parties utilizing e-mail.

21. - 43. (Cancelled)

44. (Previously Presented) A computer readable medium encoded with an intellectual property data structure for realizing the function of organizing and reporting information associated with an identifier, comprising:

an identifier object;

a notes object correlated with the identifier object for tracking manually entered notes including text associated with the identifier object; and

at least one patent object correlated with the identifier object for tracking a plurality of related patent identifiers associated with the identifier object;

wherein a set of the patents is reported utilizing the computer readable medium with:

computer code embodied on the computer readable medium for displaying a technology mapping depicting a plurality of categories of technology utilizing a graphical user interface,

computer code embodied on the computer readable medium for displaying statistics regarding a number of the patents of the set in each of the categories of technology in a first interface,

computer code embodied on the computer readable medium for displaying first additional information associated with at least a portion of the patents of the set in a second interface separate from the first interface upon the selection of an icon positioned in the first interface and associated with one of the statistics, for drilling down from the first interface to the second interface, wherein the first additional information includes a list of the patents of the set associated with one of the categories of technology, and

computer code embodied on the computer readable medium for displaying second additional information associated with at least one of the patents of the list in a third interface separate from the first interface and the second interface upon the selection of an additional icon positioned in the second interface and associated with one of the patents, for drilling down from the second interface to the third interface, where the second additional information includes a patent number, a status, an exemplary claim, and an exemplary figure;

wherein the notes are made accessible to other parties.

45. (Previously Presented) A computer readable medium encoded with an intellectual property data structure for realizing the function of organizing and reporting information associated with an identifier, comprising:

an identifier object;

a notes object correlated with the identifier object for tracking manually entered notes including text associated with the identifier object;

at least one file object correlated with the identifier object by providing a correspondence between the file object and the identifier object, for tracking manually selected files associated with the identifier object; and

at least one patent object correlated with the identifier object for tracking a plurality of related patent identifiers associated with the identifier object;

wherein a set of the patents is reported utilizing the computer readable medium with:

computer code embodied on the computer readable medium for displaying a technology mapping depicting a plurality of categories of technology utilizing a graphical user interface,

computer code embodied on the computer readable medium for displaying statistics regarding a number of the patents of the set in each of the categories of technology in a first interface,

computer code embodied on the computer readable medium for displaying first additional information associated with at least a portion of the patents of the set in a second interface separate from the first interface upon the selection of an icon positioned in the first interface and associated with one of the statistics, for drilling down from the first interface to the second interface, wherein the first additional information includes a list of the patents of the set associated with one of the categories of technology, and

computer code embodied on the computer readable medium for displaying second additional information associated with at least one of the patents of the list in a third interface separate from the first interface and the second interface upon the selection of an additional icon positioned in the second interface and associated with one of the patents, for drilling down from the second interface to the third interface, where the second additional information includes a patent number, a status, an exemplary claim, and an exemplary figure.

IX EVIDENCE APPENDIX (37 C.F.R. § 41.37(c)(1)(ix))

There is no such evidence.

X RELATED PROCEEDING APPENDIX (37 C.F.R. § 41.37(c)(1)(x))

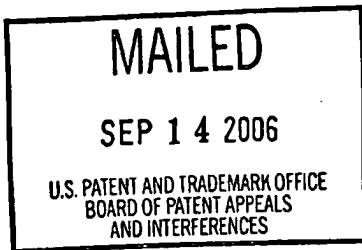
Please see attached.

The opinion in support of the decision being entered today
was **not** written for publication in and
is **not** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KEVIN J. ZILKA and DOMINIC M. KOTAB



Appeal No. 2006-1256
Application No. 10/660,830

ON BRIEF

Before LEVY, NAPPI and FETTING, Administrative Patent Judges.

NAPPI, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. §134(a) of the final rejection of claims 1, 3 5, 7 through 10, 12 through 16, and 18 through 20. For the reasons stated *infra* we affirm-in-part the examiner's rejection of these claims.

Invention

The invention relates to a computer program for reporting on competing activity or patent information during strategic intellectual property management. See page 1 of appellants' specification.

Claim 1 is representative of the invention and reproduced below:

1. A method for reporting on competing patent

information during strategic intellectual property management utilizing a computer implemented system including a computer program product embodied on a computer readable medium, comprising:

receiving information relating to a status associated with an intellectual property identifier identifying intellectual property, wherein the status is received from a docketing system for docketing corporate intellectual property assets specific to at least one corporate entity and docketing due dates associated therewith;

identifying competing patent information associated with the intellectual property identifier; and

generating a report involving the competing patent information relevant to the status associated with the intellectual property identifier identifying the intellectual property;

wherein said method is, at least in part, carried out utilizing the computer implemented system, for reporting on competing patent information.

References

The references relied upon by the examiner are:

Hagelin	US 2002/0077835 A1	Jun. 20, 2002
Snyder	US 2002/0111953 A1	Aug. 15, 2002
Del Vecchio et al. (Del Vecchio)	US 2003/0036945 A1	Feb. 20, 2003 (filed May 22, 2001)
Stobbs et al. (Stobbs)	US 2004/0181427 A1	Sep. 16, 2004 (filed Mar. 22, 2004)

Rejection at Issue

Claims 1, 3, 5, 7 through 10, 12 through 16, and 18 through 20 stand rejected under 35 U.S.C. § 112 first paragraph as failing to comply with the written description requirement. The examiner's rejection under 35 U.S.C. § 112 first paragraph, is set forth on pages 5 and 6 of the answer. Claims 1, 3, 5, 7 through 10, 12 through 16, and 18 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The examiner's rejection under 35 U.S.C. § 101 is set forth on pages 6 and 7 of the answer. Claims 1, 3, 5, 7 through 10, 12 through 16, and 18 through 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Del Vecchio in view of Stobbs and Snyder. The examiner's rejection under 35 U.S.C. § 103 is set forth on pages 8 through 17 of the answer. Throughout the opinion we make reference to the briefs, the answer and the final Office action for the respective details thereof.

Opinion

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

With full consideration being given to the subject matter on appeal, the examiner's rejections and the arguments of appellants and the examiner, and for the reasons stated *infra* we sustain the examiner's rejection of claims 1, 3, 5, 7 through 9, 12 through 14, and 16, 18, 19 under 35 U.S.C. § 103. However, we will not sustain the examiner's rejection of claims 10, 15 and 20 under 35 U.S.C. § 103, nor will we sustain the examiner's rejections under 35 U.S.C. § 101 or 35 U.S.C. § 112, first paragraph.

Rejections under 35 U.S.C. § 112, first paragraph

With respect to claims 1, 3, 5, 7 through 10, 12 through 16, 18 and 20, the examiner states, on pages 5 and 6 of the answer, that the specification does not provide written description of the limitation of "a docketing system for docketing corporate intellectual property assets specific to at least one corporate entity and docketing due dates associated therewith." Further, with respect to claim 19, the examiner states on page 6 of the answer, that the specification does not provide written description of the limitations of "with at least one first corporate entity, the report generated using patent information specific to at least one second corporate entity separate from the first corporate entity" and "a docketing system now claimed as being a docketing system for docketing corporate intellectual property assets specific to at least one corporate entity and docketing due dates associated therewith."

Appellants argue, on page 11 of the brief, that support for the docketing system for docketing corporate intellectual property and docketing due dates associated therewith is described in appellants' specification on page 41, lines 6-11 and page 9, lines 1-5. Further, on page 12 of the brief, appellants argue that the claim 19 limitation of a report generated using patent information specific to at least one second corporate entity separate from the first corporate entity, is described in appellants' specification page 41, lines 24 and page 42, line 7.

We disagree with the examiner's rationale. The written description requirement serves "to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him; how the specification accomplishes this is not material." *In re Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). In order to meet the written description requirement, the appellants do not have to utilize any particular form of disclosure to describe the subject matter claimed, but "the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). Put another way, "the applicant must . . . convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or

she was in possession of the invention." *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). Finally, "[p]recisely how close the original description must come to comply with the description requirement of § 112 must be determined on a case-by-case basis." *Eiselstein v. Frank*, 52 F.3d 1035, 1039, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995) (quoting *Vas-Cath*, 935 F.2d at 1561, 19 USPQ2d at 1116).

In this case we consider the following disclosure in appellants' specification to provide adequate written description of the limitations directed to a docketing system for docketing corporate intellectual property assets specific to at least on corporate entity and docketing due dates associated therewith. Page 9, lines 1-3 of appellants' specification states "the intellectual property identifiers in the databases 120 may be owned by a particular company or other entity in the form of a docketing database or the like", which we consider to demonstrate that appellants possessed, at the time of filing of the application, use of a corporate docketing system. Further, page 35 lines 19 through 26, and page 41, lines 6 through 11 of appellants' specification identify that the docketing system is used to generate "action items" which require filing of documents in a timely manner. We consider these portions of the appellants' originally filed disclosure to demonstrate that appellants, at the time of filing the application, had possession of the docketing system which docket due dates.

With regard to claim 19, we note that page 10 of the originally filed disclosure discusses competing activity reporting and discusses querying databases to obtain information on competing activities. We consider this disclosure, and the description on page 9, lines 1 through 5, of using both corporate owned docketing systems and published databases to demonstrate that appellants, at the time of filing the application, had possession of a report generated using patent information specific to at least one second corporate entity separate from the first corporate entity. Thus, for the forgoing reasons we find that the appellants' originally filed specification demonstrates that as of the filing date sought, the inventors were in possession of the limitations of claims 1, 3, 5, 7 through 10, 12 through 16, 18 through 20. Accordingly, we will not sustain the

examiner's rejection under 35 U.S.C. § 112, first paragraph.

Rejection under 35 U.S.C. § 101

The examiner's rejection is set forth on pages 6 and 7 of the answer and applies a "technological arts" test to determine whether the subject matter of the claims is statutory under 35 U.S.C. § 101. As stated in our recent precedential decision in *Ex parte Lundgren*, 76 USPQ2d 1385 (Bd. Pat. App. & Int. 2005), "there is currently no judicially recognized separate 'technological arts' test to determine patent eligible subject matter under §101" *Lundgren*, 76 USPQ2d at 1388. The appropriate analysis for a rejection under §101 can be found in the *Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility*, 1300 Off. Gaz. Patent and Trademark Off. (O.G.) 142, 152 (Nov. 22, 2005). Thus, as the examiner's basis for rejecting the claims under §101 is based upon "technological arts" test which is not judicially recognized, we will not sustain the examiner's rejection under 35 U.S.C. § 101.

Rejections under 35 U.S.C. § 103

On pages 14 the brief, appellants group claims 3, 5, 7 through 9, 12, 13 and 16 with claim 1. Appellants argue on page 15 of the brief that Del Vecchio does not teach receiving information from a docketing system as claimed in claim 1. Rather, appellants state that Del Vecchio teaches using a public patent database which does not docket due dates as claimed in claim 1. On page 8 of the reply brief, appellants argue that Del Vecchio and Snyder are non-analogous art. On page 16 of the brief and page 8 of the reply brief, appellants argue that combining of Del Vecchio with Snyder's docketing system would produce an unworkable combination. Further, on page 16 of the brief and page 9 of the reply brief, appellants argue that Del Vecchio does not "mention of any sort competing patent information specifically associated with the intellectual property identifier, as claimed in the preceding receiving operation." Appellants also argue on page 17 of the brief that Del Vecchio does not teach "generating a report involving the competing patent information relevant to the status associated with the intellectual property identifier identifying the intellectual property" as claimed in claim 1.

The examiner's response is on pages 21 through 31 of the answer. On pages 23 through 25 of the answer, the examiner relies upon a dictionary definition of the term docket and explains how Del Vecchio is considered to meet limitations of claim 1. Further, on page 27 of the answer, the examiner identifies that the peer group data of Del Vecchio is considered to be competing patent information. On page 30 of the answer, the examiner states that the report generated in Del Vecchio's step 28 (of figure 3) "involves the competing information relevant to the status associated with the intellectual property identifier."

We concur with the examiner's rationale and add the following further explanation. Del Vecchio teaches a system to value intellectual property. See abstract. Financial institutions such as brokerage houses use this valuation. See paragraph 2. Del Vecchio teaches that information concerning the patent or portfolio of patents can be obtained from a database such as that at USPTO.gov or other databases. See paragraph 42. We do not consider paragraph 42 to limit Del Vecchio's teachings to only the databases available at USPTO.gov, but rather to identify it as one possible source of data. Del Vecchio also makes use of the database to access peer group data. Note, element 32 in figure 3 identifies peer group data as including patent holdings, see also paragraph 45. Del Vecchio teaches many types of reports can be generated for example market analysis may require reports of average patent term, or future patent power (see paragraphs 55 through 57) or insurers may perform risk assessment for patent validity or patent infringement insurance (see paragraphs 76). A potential investor in a company would use the system of Del Vecchio to analyze the patent portfolio of one company as compared against the portfolio of competition. See paragraphs 56 and 57. This analysis makes use of calculations of average term of one company's portfolio as compared to the competitor's patent portfolio.

See column 55. We consider the term of a company's patent portfolio to represent a status of an intellectual property identifier, which is obtained from the database. We note that paragraph 114, states that the system can be used on an individual patent or a portfolio of patents. The report that presents this analysis necessarily contains

information about related information (i.e. the competitor's patent portfolio and average term), which is relevant to the status of the patent or portfolio of company being evaluated (i.e. term/average term of company's patent/portfolio). Thus, we find that Del Vecchio teaches obtaining information relevant to the status of an intellectual property identifier, identifying competing patent information and generating a report involving the competing patent information relevant to the status associated with the intellectual property identifier. Further, we do not find that Del Vecchio's teaching of using data relating to the status of a company's patent portfolio such as from USPTO.gov, to preclude sourcing the data from a docketing database.

Turning to Snyder, we find that Snyder teaches a docketing system for recording transactions and reporting deadlines associates with legal cases. See abstract. Snyder teaches that the docketing system is accessible by many parties involved in technology development, including financial institutions. See paragraph 46. We consider this teaching to suggest that financial valuing systems such as Del Vecchio's access the docketing system of Snyder. Thus we find ample evidence to support the examiner's combination of Del Vecchio with Snyder.

We note that appellants have presented no arguments directed to error in combining Del Vecchio and Snyder with Stubbs as set for the in the examiner's rejection. Thus, for the forgoing reasons, we are not persuaded of any error in the examiner's rejection of claims 1, 3, 5, 7 through 9, 12, 13 and 16 under 35 U.S.C. § 103 as being unpatentable over Del Vecchio in view of Snyder and Stubbs.

Claim 10

On page 17 of the brief, appellants provide a separate argument as to the examiner's rejection of claim 10. Appellants argue that the examiner's taking of official notice of a "license map" does not meet the burden of proving a *prima facie* case. Further, on page 10 of the reply brief, appellants argue that Hagelin, which the examiner cites to support the taking of official noticed facts, only mentions "calculating the value of a license to a licensor and licensee" and not a report that includes a license map as

claimed in claim 10.

The examiner responds on page 33 of the answer stating:

[I]t is old and well known to take into account licensing information when calculating competitive advantage of intellectual property assets as is evidenced by Hagelin (US 2002/0077835) and further indicated in the rejection that it would have been obvious to one of ordinary skill in the art at the time of the invention to include licensing information when comparing competing assets since the value of the license is crucial to the value of the intellectual property and thus any competitive advantage of the asset.

We disagree with the examiner. Claim 10 recites that the report of claim 1 includes a “license map.” Page 27 of appellants’ specification identifies a license map as correlating the technology covered by a patent with activities of competitors. Appellants’ specification identifies that the license map may be used to determine if the patent has significant licensing potential. Thus, we do not construe the claim term “license map” as containing license information, but rather a report that correlates patent technology with competitors’ actions, which may be useful in determining licensing potential. As claim 10 is dependent upon claim 1 it includes the limitations of claim 1, thus, we consider the scope of claim 10 to include that a report involving competing patent information relevant to the status of the intellectual property identifier where in the report includes a correlation of competing activities to the intellectual property identified by the intellectual property identifier. We do not find that Del Vecchio teaches or suggests such a report, nor do we find that Hagelin teaches or suggests modifying Del Vecchio’s system to include such a report. Accordingly we will not sustain the examiner’s rejection of claim 10 under 35 U.S.C. § 103.

Claim 14

On page 18 of the brief, appellants provide a separate argument as to the examiner’s rejection of claim 14. Appellants argue, “Del Vecchio makes absolutely no mention as to the format of the report being based on the status, as claimed.”

We are not persuaded by appellants' argument. Claim 14 is dependent upon claim 1 and recites, "wherein a format of the report is based upon status." As discussed *supra*, with respect to claim 1, we find that Del Vecchio's system can produce different types of reports, including a report directed to the number of years of patent term remaining for a patent or portfolio. As also discussed *supra*, we consider the remaining term of the patent to be a status of the patent. Clearly, reports, which make use of different analysis, will use different format, for example the "Mod Factor" analysis used by insurers (discussed in paragraph 76) will have a different format than patent term remaining analysis discussed *supra*. Thus, we find that one of the reports, which can be generated by Del Vecchio's system, is based on the status of the intellectual property identified by the intellectual property identifier. Accordingly, we sustain the examiner's rejection of claim 14 under 35 U.S.C. § 103.

Claim 15

On page 18 of the brief, appellants provide a separate argument as to the examiner's rejection of claim 15. Appellants argue "Del Vecchio makes absolutely no mention as to the destination being based on the status, as claimed."

We concur with the appellants. Claim 15 is dependent upon claim 1 and recites, "wherein a destination of the report is based on the status." We find no teaching or suggestion in Del Vecchio, Stobbs or Snyder that the destination of the report should be based upon the status. Accordingly, we will not sustain the examiner's rejection of claim 15.

Claims 18 and 19.

On pages 18 and 19 of the brief, appellants group claims 18 and 19 together. On page 19 of the brief appellants assert that the arguments presented with respect to claim 1 also apply to claims 18 and 19. Further, appellants argue that Del Vecchio does not "mention of any sort competing patent information specifically associated with the intellectual property identifier, as claimed in the preceding receiving operation." On page 20 of the brief, appellants argue "[o]nly appellant [sic] teaches and claims such a

competing patent information report that is particularly relevant to the information associated with the intellectual property identifier identifying the intellectual property (which was received via a docketing system), in the claimed manner.” Appellants present similar arguments on pages 13 and 14 of the reply brief.

We are not persuaded by appellants’ arguments. Initially we note, appellants group claims 18 and 19. Claim 19 recites “wherein the information is received from at least one of a docketing system for docketing corporate intellectual property specific to a corporate entity, and a comprehensive database of substantially all patents issued by at least one government agency.” Claim 19 thus refers to the docketing system in the alternative, i.e. to meet the claim one of either a docketing system or a government database of all patents is required. As such appellants arguments directed to Del Vecchio not making use of a database are not commensurate with the scope of the claim. As stated *supra*, Del Vecchio teaches making use of databases available at USPTO.gov, which is a government database of all patents. As discussed *supra*, with respect to claim 1, we find that Del Vecchio teaches generating a report that associates competing patent information with that of a company. As appellants’ arguments have not persuaded us of error in the examiner’s rejection, we sustain the examiner’s rejection of claims 18 and 19.

Claim 20

On page 21 of the brief, appellants assert that the arguments presented with respect to claim 1 also apply to claims 20. Further, appellants argue that Del Vecchio does not teach, “generating a report involving the competing activity relevant to the status associated with the intellectual property identifier identifying the intellectual property.”

We concur with appellants. Claim 20 recites “generating a report involving the competing activity relevant to the status associated with the intellectual property identifier identifying the intellectual property” wherein “the competing activity including activity that does or potentially would infringe or interfere with the rights appurtenant to the intellectual property.” We do not find that Del Vecchio teaches or suggests such a report, nor do we find that Hagelin teaches or suggests modifying Del Vecchio’s system

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to include such a report. Accordingly we will not sustain the examiner's rejection of claim 20 under 35 U.S.C. § 103.

Conclusion

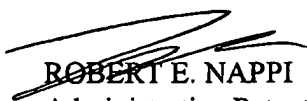
In summary, we sustain the examiner's rejection of claims 1, 3, 5, 7 through 9, 10, 12 through 14, and 16, 18, 19 under 35 U.S.C. § 103. However, we will not sustain the examiner's rejection of claims 10, 15 and 20 under 35 U.S.C. § 103, nor will we sustain the examiner's rejections under 35 U.S.C. § 101 or 35 U.S.C. § 112, first paragraph. The decision of the examiner is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(vii).

AFFIRMED-IN-PART



STUART S. LEVY
Administrative Patent Judge



ROBERT E. NAPPI
Administrative Patent Judge



ANTON W. FETTING
Administrative Patent Judge

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Appeal No. 2006-1256
Application No. 10/660,830

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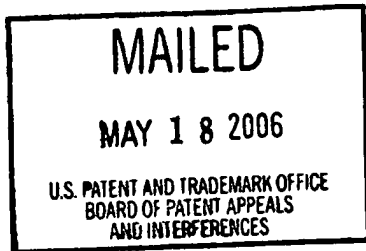
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The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KEVIN J. ZILKA and DOMINIC M. KOTAB



Appeal No. 2006-1060
Application No. 10/691,060

ON BRIEF

Before OWENS, LEVY, and NAPPI, *Administrative Patent Judges*
OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal is from a rejection of claims 1-4, 7-17 and 20-41. Claim 24 is canceled in the reply brief (page 6).¹

THE INVENTION

The appellants claim a method for preselecting an identifier and automatically correlating with it content associated with at least one uniform resource locator. Claim 1 is illustrative:

¹ Whether or not the cancellation of claim 24 in the reply brief has been submitted in a separate paper and entered, we consider the appellants' cancellation of claim 24 to be a withdrawal of the appeal as to that claim.

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Application No. 10/691,060

1. A computer-implemented identifier pre-selection method for use in association with a network browser, comprising:

in association with a network browser for browsing content on a network including the Internet, displaying a plurality of identifiers adjacent to a window in which content associated with uniform resource locators (URLs) is displayed, utilizing a processor coupled to memory;

allowing a user to pre-select one of the identifiers; and thereafter,

displaying the content associated with at least one URL utilizing the network browser, and

storing selected displayed content and correlating the content with the pre-selected identifier;

wherein any content selected during use of the network browser results in automatic correlation of the content with the pre-selected identifier.

THE REFERENCE

Rivette et al. (Rivette) 2003/0046307 Mar. 06, 2003

THE REJECTION

Claims 1-4, 7-9, 12, 14-17 and 20-23 and 25-41 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Rivette.

OPINION

We affirm the aforementioned rejection. We address the claims separately to the extent justified by the appellants'

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Application No. 10/691,060

arguments, see 37 CFR § 41.37(c)(1)(vii)(2004), and we incorporate herein the explanations of the rejections and the responses to the appellants' arguments in the examiner's answer.

The appellants argue that the examiner is inconsistent in relying upon both Rivette's display of patent numbers and notes as being content, and that the notes are not associated with a URL (reply brief, pages 12-20). Rivette's patent numbers are identifiers as that term is used by the appellants (specification, page 8, line 12). In Rivette's figure 148, the patent numbers are hyperlinks correlated with the content displayed to the right of the hyperlinks. Hence, Rivette meets the appellants' claim requirement for preselecting an identifier and thereafter displaying, using a network browser, content that is associated with at least one URL and is correlated with the identifier.

The appellants argue that their term "identifier" should not be limited to a patent number (reply brief, pages 21-23), which is correct. However, as pointed out above, that term includes patent numbers.

The appellants argue that their term "preselect" is not limited to selecting an existing identifier (reply brief,

page 24), which is correct. That term, however, includes selecting an existing identifier such as Rivette's patent numbers.

The appellants argue that claim 26 requires extracting a plurality of terms from a claim, and not merely receiving the terms from an operator (reply brief, page 25). The claim includes extraction of a plurality of terms from a claim by an operator.

Regarding claims 29 and 30 the appellants argue that Rivette does not disclose identifying noun or verb terms of the claim (reply brief, page 26). Claim 26, from which claims 29 and 30 depend, requires that a search is capable of being performed, and that the search includes extracting a plurality of terms from the claim. The extraction necessarily encompasses identification of any of the terms in the claim, including the nouns and verbs.

As for claims 33 and 34, the appellants argue that Rivette's disclosure of selecting search terms using a thesaurus is not a disclosure of identifying synonyms based on the terms of the claim and incorporating the synonyms with claim terms (reply brief, page 27). Rivette's disclosure of search strategies

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including, but not limited to, keyword phrases with thesaurus (0395), is a disclosure of a search that incorporates keywords, i.e., claim terms, and synonyms, i.e., thesaurus terms.

With respect to claim 36, the appellants argue that removing the word "claim" from the terms of a claim is not the same as excluding "claim" from an operator's search (reply brief, page 27). The appellants have not pointed out, and it is not apparent, how their term "removed", with respect to possible search terms, differs from "excluded" in that context.

The appellants argue, regarding claims 40 and 41, that Rivette's disclosure that a user is enabled to manipulate and process search results (0396) is not a disclosure of modifying terms based on results and user input (reply brief, page 28). Rivette's disclosure that new search criteria can be added to the search criteria in a prior search (0397) is a disclosure of modifying the terms of the search based on the results of the search and user input.

For the above reasons we are not convinced of reversible error in the examiner's rejection.

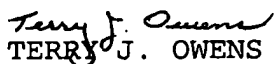
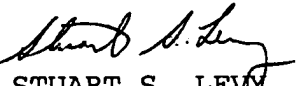
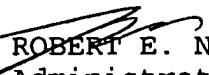
Appeal No. 2006-1060
Application No. 10/691,060

DECISION

The rejection of claims 1-4, 7-9, 12, 14-17 and 20-23
and 25-41 under 35 U.S.C. § 102(e) over Rivette is affirmed.

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a)(1)(iv).

AFFIRMED


TERRY J. OWENS)
Administrative Patent Judge)
)
)

STUART S. LEVY)
Administrative Patent Judge)
)
)
)

ROBERT E. NAPPI)
Administrative Patent Judge)

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INTERFERENCES

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Application No. 10/691,060

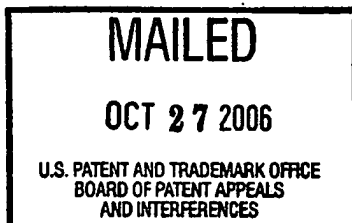
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The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KEVIN J. ZILKA and DOMINIC M. KOTAB



Appeal No. 2006-1060
Application No. 10/691,060
Technology Center 3600

ON BRIEF

Before OWENS, LEVY and NAPPI, *Administrative Patent Judges*.
OWENS, *Administrative Patent Judge*.

ON REQUEST FOR REHEARING

The appellants request rehearing of our decision to affirm the examiner's rejection of claims 1-4, 7-9, 12, 14-17, 20-23 and 25-41 under 35 U.S.C. § 102(e) as being anticipated by US 2003/0046307 to Rivette.

The appellants argue that Rivette does not disclose, after allowing a user to pre-select one of a plurality of displayed identifiers, storing selected displayed content and correlating the content with the pre-selected identifier, wherein any content selected during use of the network browser results in automatic correlation of the content with the pre-selected identifier (request, page 4).

Rivette discloses allowing a user to pre-select one of a plurality of displayed identifiers (patent numbers in figures 145B, 147 and 148), and then displaying the content associated with a URL (i.e., patent content) utilizing a network browser (§§ 1229, 1242 and 1243). Thereafter, the user can select a portion of the displayed document and link that portion to another portion of the same document (§ 1235). The information pertaining to the linked portion can be stored in a cache within the client (§ 1238). The user-defined link is stored in a database table wherein it is correlated with the document and the linked portions of the document (§ 1237). Thus, any displayed content selected using the network browser is stored and automatically correlated with the pre-selected identifier (patent number).

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We have considered the appellants' request for rehearing but, for the above reasons, we are not persuaded of error in our decision. Accordingly, the request for rehearing is denied.

DENIED

Terry J. Owens)
TERRY J. OWENS)
Administrative Patent Judge)


STUART S. LEVY
Administrative Patent Judge

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ROBERT E. NAPPI
Administrative Patent Judge

Appeal No. 2006-1060
Application No. 10/691,060

ZILKA-KOTAB, PC
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SAN JOSE, CA 95172-1120

TJO/lg

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 971-2573. For payment of any additional fees due in connection with the filing of this paper, the Commissioner is authorized to charge such fees to Deposit Account No. 50-1351 (Order No. SVIPGP002B).

Respectfully submitted,

By: /KEVINZILKA/ Date: May 27, 2008
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